

§ 1026. Repealed. Pub. L. 94-136, title VI, § 601, Nov. 28, 1975, 89 Stat. 742

Section, Pub. L. 92-210, § 4, Dec. 22, 1971, 85 Stat. 753; Pub. L. 93-34, May 14, 1973, 87 Stat. 72, created the President's National Commission on Productivity and authorized appropriations for its operation through June 30, 1973. Thereafter, the Commission's name was changed to the National Commission on Productivity and Work Quality by Pub. L. 93-311, June 8, 1974, 88 Stat. 236 and appropriations were authorized to continue operations through November 30, 1975, by Pub. L. 94-42, § 2, June 28, 1975, 89 Stat. 232, and Pub. L. 94-100, § 2, Oct. 1, 1975, 89 Stat. 483. See section 2401 et seq. of this title.

CHAPTER 22—TRADE-MARKS

SUBCHAPTER I—THE PRINCIPAL REGISTER

- Sec.
1051. Registration of trade-marks.
 (a) Trade-marks used in commerce.
 (b) Trade-marks intended for use in commerce.
 (c) Amendment of application under subsection (b) to conform to requirements of subsection (a).
 (d) Verified statement that trade-mark is used in commerce.
 (e) Designation of resident for service of process and notices.
1052. Trade-marks registrable on principal register; concurrent registration.
1053. Service marks registrable.
1054. Collective marks and certification marks registrable.
1055. Use by related companies affecting validity and registration.
1056. Disclaimer of unregistrable matter.
 (a) Compulsory and voluntary disclaimers.
 (b) Prejudice of rights.
1057. Certificates of registration.
 (a) Issuance and form.
 (b) Certificate as prima facie evidence.
 (c) Application to register mark considered constructive use.
 (d) Issuance to assignee.
 (e) Surrender, cancellation, or amendment by registrant.
 (f) Copies of Patent and Trademark Office records as evidence.
 (g) Correction of Patent and Trademark Office mistake.
 (h) Correction of applicant's mistake.
1058. Duration of registration.
 (a) Affidavit of continuing use.
 (b) Registration published under other provisions of law.
 (c) Notification of acceptance or refusal of affidavits.
1059. Renewal of registration.
 (a) Period of renewal; time for renewal.
 (b) Notification of refusal of renewal.
 (c) Applicant for renewal not domiciled in United States.
1060. Assignment of mark; execution; recording; purchaser without notice.
1061. Execution of acknowledgments and verifications.
1062. Publication.
 (a) Examination and publication.
 (b) Refusal of registration; amendment of application; abandonment.
 (c) Republication of marks registered under prior acts.
1063. Opposition to registration.
1064. Cancellation of registration.
1065. Incontestability of right to use mark under certain conditions.

- Sec.
1066. Interference; declaration by Commissioner.
1067. Interference, opposition, and proceedings for concurrent use registration or for cancellation; notice; Trademark Trial and Appeal Board.
1068. Action of Commissioner in interference, opposition, and proceedings for concurrent use registration or for cancellation.
1069. Application of equitable principles in inter partes proceedings.
1070. Appeals to Trademark Trial and Appeal Board from decisions of examiners.
1071. Appeal to courts.
 (a) Persons entitled to appeal; United States Court of Appeals for the Federal Circuit; waiver of civil action; election of civil action by adverse party; procedure.
 (b) Civil action; persons entitled to; jurisdiction of court; status of Commissioner; procedure.
1072. Registration as constructive notice of claim of ownership.

SUBCHAPTER II—THE SUPPLEMENTAL REGISTER

1091. Supplemental register.
 (a) Marks registerable.
 (b) Application and proceedings for registration.
 (c) Nature of mark.
1092. Publication; not subject to opposition; cancellation.
1093. Registration certificates for marks on principal and supplemental registers to be different.
1094. Provisions of chapter applicable to registrations on supplemental register.
1095. Registration on principal register not precluded.
1096. Registration on supplemental register not used to stop importations.

SUBCHAPTER III—GENERAL PROVISIONS

1111. Notice of registration; display with mark; recovery of profits and damages in infringement suit.
1112. Classification of goods and services; registration in plurality of classes.
1113. Fees.
 (a) Applications; services; materials.
 (b) Waiver; Indian products.
1114. Remedies; infringement; innocent infringement by printers and publishers.
1115. Registration on principal register as evidence of exclusive right to use mark; defenses.
 (a) Evidentiary value; defenses.
 (b) Incontestability; defenses.
1116. Injunctive relief.
 (a) Jurisdiction; service.
 (b) Transfer of certified copies of court papers.
 (c) Notice to Commissioner.
 (d) Civil actions arising out of use of counterfeit marks.
1117. Recovery for violation of rights.
 (a) Profits; damages and costs; attorney fees.
 (b) Treble damages for use of counterfeit mark.
 (c) Election of award of statutory damages.
1118. Destruction of infringing articles.
1119. Power of court over registration.
1120. Civil liability for false or fraudulent registration.
1121. Jurisdiction of Federal courts; State and local requirements that registered trademarks be altered or displayed differently; prohibition.

- Sec.
 1121a. Transferred.
 1122. Liability of States, instrumentalities of States, and State officials.
 (a) Waiver of sovereign immunity.
 (b) Remedies.
 1123. Rules and regulations for conduct of proceedings in Patent and Trademark Office.
 1124. Importation of goods bearing infringing marks or names forbidden.
 1125. False designations of origin, false descriptions, and dilution forbidden.
 (a) Civil action.
 (b) Importation.
 (c) Remedies for dilution of famous marks.
 1126. International conventions.
 (a) Register of marks communicated by international bureaus.
 (b) Benefits of section to persons whose country of origin is party to convention or treaty.
 (c) Prior registration in country of origin; country of origin defined.
 (d) Right of priority.
 (e) Registration on principal or supplemental register; copy of foreign registration.
 (f) Domestic registration independent of foreign registration.
 (g) Trade or commercial names of foreign nationals protected without registration.
 (h) Protection of foreign nationals against unfair competition.
 (i) Citizens or residents of United States entitled to benefits of section.
 1127. Construction and definitions; intent of chapter.

EFFECTIVE DATE

This chapter, act July 5, 1946, ch. 540, 60 Stat. 427, became effective one year from July 5, 1946, and repealed chapter 3 of this title as of that date. See notes under section 1051 of this title.

PRIOR LAWS

The Trade-Mark Act of 1905 superseded the Trade-Mark Act of Mar. 3, 1881, ch. 138, 21 Stat. 502, entitled "An Act to authorize the registration of trade-marks and protect the same," and also act Aug. 5, 1882, ch. 393, 22 Stat. 298, entitled "An Act relating to the registration of trade marks". Former section 109 of this title repealed all inconsistent acts and parts of acts, except so far as they might apply to certificates of registration issued under the Trade-Mark Act of Mar. 3, 1881, ch. 138, and act Aug. 5, 1882, ch. 393.

CHAPTER REFERRED TO IN OTHER SECTIONS

This chapter is referred to in title 18 section 2320; title 19 section 1337; title 22 section 2141c; title 36 section 380; title 48 section 1643.

SUBCHAPTER I—THE PRINCIPAL REGISTER

§ 1051. Registration of trade-marks

(a) Trade-marks used in commerce

The owner of a trade-mark used in commerce may apply to register his or her trade-mark under this chapter on the principal register established:

(1) By filing in the Patent and Trademark Office—

(A) a written application, in such form as may be prescribed by the Commissioner, verified by the applicant, or by a member of the firm or an officer of the corporation or

association applying, specifying applicant's domicile and citizenship, the date of applicant's first use of the mark, the date of applicant's first use of the mark in commerce, the goods in connection with which the mark is used and the mode or manner in which the mark is used in connection with such goods, and including a statement to the effect that the person making the verification believes himself, or the firm, corporation, or association in whose behalf he makes the verification, to be the owner of the mark sought to be registered, that the mark is in use in commerce, and that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive; *Provided*, That in the case of every application claiming concurrent use the applicant shall state exceptions to his claim of exclusive use, in which he shall specify, to the extent of his knowledge, any concurrent use by others, the goods on or in connection with which and the areas in which each concurrent use exists, the periods of each use, and the goods and area for which the applicant desires registration;

(B) a drawing of the mark; and

(C) such number of specimens or facsimiles of the mark as used as may be required by the Commissioner.

(2) By paying into the Patent and Trademark Office the prescribed fee.

(3) By complying with such rules or regulations, not inconsistent with law, as may be prescribed by the Commissioner.

(b) Trade-marks intended for use in commerce

A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may apply to register the trademark under this chapter on the principal register hereby established:

(1) By filing in the Patent and Trademark Office—

(A) a written application, in such form as may be prescribed by the Commissioner, verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, specifying applicant's domicile and citizenship, applicant's bona fide intention to use the mark in commerce, the goods on or in connection with which the applicant has a bona fide intention to use the mark and the mode or manner in which the mark is intended to be used on or in connection with such goods, including a statement to the effect that the person making the verification believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the verification, to be entitled to use the mark in commerce, and that no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the

identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive; however, except for applications filed pursuant to section 1126 of this title, no mark shall be registered until the applicant has met the requirements of subsection (d) of this section; and

(B) a drawing of the mark.

(2) By paying in the Patent and Trademark Office the prescribed fee.

(3) By complying with such rules or regulations, not inconsistent with law, as may be prescribed by the Commissioner.

(c) Amendment of application under subsection (b) to conform to requirements of subsection (a)

At any time during examination of an application filed under subsection (b) of this section, an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this chapter, by amending his or her application to bring it into conformity with the requirements of subsection (a) of this section.

(d) Verified statement that trade-mark is used in commerce

(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 1063(b)(2) of this title to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Commissioner and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce, those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce, and the mode or manner in which the mark is used on or in connection with such goods or services. Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 1052 of this title. The notice of registration shall specify the goods or services for which the mark is registered.

(2) The Commissioner shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Commissioner may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written re-

quest of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Commissioner shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

(3) The Commissioner shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.

(4) The failure to timely file a verified statement of use under this subsection shall result in abandonment of the application.

(e) Designation of resident for service of process and notices

If the applicant is not domiciled in the United States he shall designate by a written document filed in the Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with him or mailing to him a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Commissioner.

(July 5, 1946, ch. 540, title I, § 1, 60 Stat. 427; Oct. 9, 1962, Pub. L. 87-772, § 1, 76 Stat. 769; Jan. 2, 1975, Pub. L. 93-596, § 1, 88 Stat. 1949; Nov. 16, 1988, Pub. L. 100-667, title I, § 103, 102 Stat. 3935.)

PRIOR PROVISIONS

Subsecs. (a) to (c) are from acts Feb. 20, 1905, ch. 592, §§ 1, 2, 33 Stat. 724; May 4, 1906, ch. 2081, § 1, 34 Stat. 168; Feb. 18, 1909, ch. 144, 35 Stat. 628; Apr. 11, 1930, ch. 132, § 4, 46 Stat. 155; June 10, 1938, ch. 332, § 1, 52 Stat. 638.

Subsec. (d) is from act Feb. 20, 1905, ch. 592, § 3, 33 Stat. 725.

AMENDMENTS

1988—Subsec. (a). Pub. L. 100-667, § 103(1) to (7), inserted “(a)” preceding introductory provisions and substituted “may apply to register his or her” for “may register his”, redesignated former subsecs. (a) to (c) as pars. (1) to (3), respectively, redesignated former pars. (1) to (3) as subpars. (A) to (C), respectively, in par. (1)(A), substituted “used on or in connection with” for “applied to” and “goods on or in connection” for “goods in connection”, in par. (1)(C), struck out “actually” after “the mark as”, and in par. (2), substituted “prescribed” for “filing”.

Subsecs. (b), (c). Pub. L. 100-667, § 103(3), (9), added subsecs. (b) and (c) and redesignated former subsecs. (b) and (c) as pars. (2) and (3), respectively, of subsec. (a).

Subsecs. (d), (e). Pub. L. 100-667, § 103(8), (9), added subsec. (d) and redesignated former subsec. (d) as (e).

1975—Subsecs. (a), (b), (d). Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Subsec. (a)(1). Pub. L. 87-772 substituted “as to be likely, when applied to the goods of such other per-

son, to cause confusion, or to cause mistake, or to deceive” for “as might be calculated to deceive”, and struck out “or services” after “use by others, the goods”.

EFFECTIVE DATE OF 1988 AMENDMENT

Section 136 of title I of Pub. L. 100-667 provided that: “This title and the amendments made by this title [see Short Title of 1988 Amendment note below] shall become effective on the date which is one year after the date of enactment of this Act [Nov. 16, 1988].”

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

EFFECTIVE DATE

Section 46(a) of act July 5, 1946, provided that this chapter shall be in force and take effect one year from July 5, 1946.

SHORT TITLE OF 1996 AMENDMENT

Pub. L. 104-98, §1, Jan. 16, 1996, 109 Stat. 985, provided that: “This Act [amending sections 1125 and 1127 of this title and enacting provisions set out as a note under section 1125 of this title] may be cited as the ‘Federal Trademark Dilution Act of 1995’.”

SHORT TITLE OF 1992 AMENDMENT

Pub. L. 102-542, §1, Oct. 27, 1992, 106 Stat. 3567, provided that: “This Act [enacting section 1122 of this title, amending sections 1114, 1125, and 1127 of this title, and enacting provisions set out as a note under section 1114 of this title] may be cited as the ‘Trademark Remedy Clarification Act’.”

SHORT TITLE OF 1988 AMENDMENT

Section 101 of title I of Pub. L. 100-667 provided that: “This title [amending this section and sections 1052 to 1060, 1062 to 1066, 1068, 1069, 1071, 1091, 1092, 1094, 1095, 1111, 1112, 1114 to 1118, 1121, and 1125 to 1127 of this title, redesignating section 1121a of this title as section 1121(b) of this title, and enacting provisions set out as notes under sections 1051 and 1058 of this title] may be cited as the ‘Trademark Law Revision Act of 1988’.”

SHORT TITLE OF 1984 AMENDMENT

Pub. L. 98-620, title I, §101, Nov. 8, 1984, 98 Stat. 3335, provided that: “This title [amending sections 1064 and 1127 of this title and enacting provisions set out as a note under section 1064 of this title] may be cited as the ‘Trademark Clarification Act of 1984’.”

SHORT TITLE

Act July 5, 1946, ch. 540, 60 Stat. 427, which is classified to this chapter, is popularly known as the “Lanham Act” and also as the “Trademark Act of 1946”.

REPEAL OF INCONSISTENT PROVISIONS; CERTAIN PROVISIONS NOT AFFECTED

Section 46(a) of act July 5, 1946, provided in part that all acts and parts of acts inconsistent with this chapter are repealed effective one year from July 5, 1946, but that “nothing contained in this Act [this chapter] shall be construed as limiting, restricting, modifying, or repealing any statute in force on the effective date of this Act [July 5, 1947] which does not relate to trade-marks, or as restricting or increasing the authority of any Federal department or regulatory agency except as may be specifically provided in this Act [this chapter].”

Section 48 of act July 5, 1946, provided that: “Section 4 of the Act of January 5, 1905 (U.S.C., title 36, sec. 4), as amended, entitled ‘An Act to incorporate the National Red Cross’ [see 18 U.S.C. 706], and section 7 of the Act of June 15, 1916 (U.S.C., title 36, sec. 27), entitled

‘An Act to incorporate the Boy Scouts of America, and for other purposes’, and the Act of June 20, 1936 (U.S.C., title 22, sec. 248), entitled ‘An Act to prohibit the commercial use of the coat of arms of the Swiss Confederation’ [see 18 U.S.C. 708], are not repealed or affected by this Act.”

SEPARABILITY

Section 50 of act July 5, 1946, provided that: “If any provision of this Act [this chapter] or the application of such provision to any person or circumstance is held invalid, the remainder of the Act shall not be affected thereby.”

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce to Secretary of Commerce, with certain exceptions, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

PENDING PROCEEDINGS AND EXISTING REGISTRATION AND RIGHTS UNDER PRIOR ACTS

Section 46(a) of act July 5, 1946, provided in part that this chapter, except as otherwise specifically provided therein, shall not affect any suit, proceeding or appeal pending on the effective date of this chapter and that the repeal of all inconsistent acts “shall not affect the validity of registrations granted or applied for under any of said Acts prior to the effective date of this Act [July 5, 1947], or rights or remedies thereunder except as provided in sections 8, 12, 14, 15, and 47 of this Act [sections 1058, 1062, 1064, and 1065 of this title and note under this section].”

Sections 46(b) and 47 of act July 5, 1946, provided:

“(b) Registrations now existing under the Act of March 3, 1881, or the Act of February 20, 1905 [sections 81 to 109 of this title], shall continue in full force and effect for the unexpired terms thereof and may be renewed under the provisions of section 9 of this Act [section 1059 of this title]. Such registrations and the renewals thereof shall be subject to and shall be entitled to the benefits of the provisions of this Act [this chapter] to the same extent and with the same force and effect as though registered on the principal register established by this Act [this chapter] except as limited in sections 8, 12, 14, and 15 of this Act [sections 1058, 1062, 1064, 1065, of this title]. Marks registered under the ‘ten-year proviso’ of section 5 of the Act of February 20, 1905, as amended [former section 85 of this title], shall be deemed to have become distinctive of the registrant’s goods in commerce under paragraph (f) of section 2 of this Act [section 1052 of this title] and may be renewed under section 9 hereof [section 1059 of this title] as marks coming within said paragraph.

“Registrations now existing under the Act of March 19, 1920 [former sections 121 to 128 of this title], shall expire six months after the effective date of this Act [July 5, 1947], or twenty years from the dates of their registrations, whichever date is later. Such registrations shall be subject to and entitled to the benefits of the provisions of this Act [this chapter] relating to marks registered on the supplemental register established by this Act [this chapter], and may not be renewed unless renewal is required to support foreign registrations. In that event renewal may be effected on the supplemental register under the provisions of section 9 of this Act [section 1059 of this title].

“Marks registered under previous Acts may, if eligible, also be registered under this Act [this chapter].

“SEC. 47. (a) All applications for registration pending in the Patent Office at the effective date of this Act [July 5, 1947] may be amended, if practicable, to bring them under the provisions of this Act [this chapter]. The prosecution of such applications so amended and the grant of registrations thereon shall be proceeded with in accordance with the provisions of this Act [this chapter]. If such amendments are not made, the pros-

ecution of said applications shall be proceeded with and registrations thereon granted in accordance with the Acts under which said applications were filed, and said Acts are hereby continued in force to this extent and for this purpose only, notwithstanding the foregoing general repeal thereof.

“(b) In any case in which an appeal is pending before the United States Court of Customs and Patent Appeals or any United States Circuit Court of Appeals or the United States Court of Appeals for the District of Columbia or the United States Supreme Court at the effective date of this Act [July 5, 1947], the court, if it be of the opinion that the provisions of this Act [this chapter] are applicable to the subject matter of the appeal, may apply such provision or may remand the case to the Commissioner or to the district court for the taking of additional evidence or a new trial or for reconsideration of the decision on the record as made, as the appellate court may deem proper.”

Section 49 of said act July 5, 1946, provided: “Nothing herein [in this chapter] shall adversely affect the rights or the enforcement of rights in marks acquired in good faith prior to the effective date of this Act [July 5, 1947].”

EMERGENCY RELIEF FROM POSTAL SITUATION AFFECTING TRADEMARK CASES

Relief as to filing date of trademark application or registration and excusal of delayed fees or actions affected by postal situation beginning on Mar. 18, 1970, and ending on or about Mar. 30, 1970, see note set out under section 111 of Title 35, Patents.

CROSS REFERENCES

Emblems, insignia and names—

False advertising or misuse of names to indicate Federal agency, see section 709 of Title 18, Crimes and Criminal Procedure.

Swiss Confederation coat of arms, see section 708 of Title 18.

Red Cross members or agents, false personation, see section 917 of Title 18.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1059, 1060, 1062, 1063, 1068, 1071, 1091, 1092, 1094, 1126 of this title.

§ 1052. Trade-marks registrable on principal register; concurrent registration

No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the

name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Commissioner when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Commissioner shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, or (4) is primarily merely a surname.

(f) Except as expressly excluded in paragraphs (a), (b), (c), (d), and (e)(3) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as *prima facie* evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which,

when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

(July 5, 1946, ch. 540, title I, § 2, 60 Stat. 428; Oct. 9, 1962, Pub. L. 87-772, § 2, 76 Stat. 769; Jan. 2, 1975, Pub. L. 93-596, § 1, 88 Stat. 1949; Nov. 16, 1988, Pub. L. 100-667, title I, § 104, 102 Stat. 3937; Dec. 8, 1993, Pub. L. 103-182, title III, § 333(a), 107 Stat. 2114; Dec. 8, 1994, Pub. L. 103-465, title V, § 522, 108 Stat. 4982.)

REFERENCES IN TEXT

Acts March 3, 1881, and February 20, 1905, referred to in subsec. (d), are acts Mar. 3, 1881, ch. 138, 21 Stat. 502, and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, § 46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, § 5, 33 Stat. 725; Mar. 2, 1907, ch. 2573, § 1, 34 Stat. 1251; Feb. 18, 1911, ch. 113, 36 Stat. 918; Jan. 8, 1913, ch. 7, 37 Stat. 649; Mar. 19, 1920, ch. 104, § 9, 41 Stat. 535; June 7, 1924, ch. 341, 43 Stat. 647.

AMENDMENTS

1994—Subsec. (a). Pub. L. 103-465 amended subsec. (a) generally. Prior to amendment, subsec. (a) read as follows: “Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”

1993—Subsec. (e). Pub. L. 103-182, § 333(a)(1), amended subsec. (e) generally. Prior to amendment, subsec. (e) read as follows: “Consists of a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, or (3) is primarily merely a surname.”

Subsec. (f). Pub. L. 103-182, § 333(a)(2), substituted “(d), and (e)(3)” for “and (d)” and inserted at end “Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.”

1988—Subsec. (d). Pub. L. 100-667, § 104(1), amended subsec. (d) generally. Prior to amendment, subsec. (d) read as follows: “Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That when the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (i) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; or (ii) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (iii) July 5, 1947, in the case

of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Concurrent registrations may also be issued by the Commissioner when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Commissioner shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods in connection with which such mark is registered to the respective persons.”

Subsec. (e). Pub. L. 100-667, § 104(2), substituted “used on or in connection with” for “applied to” in two places.

Subsec. (f). Pub. L. 100-667, § 104(3), substituted “used on or in connection with” for “applied to” and “five years before the date on which the claim of distinctiveness is made” for “five years next preceding the date of the filing of the application for its registration”

1975—Subsec. (d). Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Subsec. (d). Pub. L. 87-772, among other changes, substituted provisions authorizing the issuance of concurrent registrations to persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to the earliest of the filing dates of the applications pending or of any registration issued under this chapter, or July 5, 1947, in the case of registrations previously issued under the act of Mar. 3, 1881, or Feb. 20, 1905, and continuing in full force and effect on that date, or July 5, 1947, in the case of applications under the act of Feb. 20, 1905, and registered after July 5, 1947, for provisions which restricted issuance of concurrent registrations to persons entitled to use such mark as a result of their concurrent lawful use thereof in commerce prior to any of the filing dates of the applications involved, and provisions directing that issuance of the mark be upon such conditions and limitations as to the mode or place of use of the marks or the goods in connection with which such marks are used, for provisions which required issuance under conditions and limitations as to the mode or place of use of the goods in connection with which such registrations may be granted, and eliminated provisions which limited confusion, mistake, or deception to purchasers, required written notice of applications for concurrent registrations and of hearings thereon, and publication in the Official Gazette upon a decision to grant such a registration and permitted a court to order such a registration under section 4915 of the Revised Statutes.

EFFECTIVE DATE OF 1994 AMENDMENT

Section 523 of title V of Pub. L. 103-465 provided that: “The amendments made by this subtitle [subtitle B (§§ 521-523) of title V of Pub. L. 103-465, amending this section and section 1127 of this title] take effect one year after the date on which the WTO Agreement enters into force with respect to the United States [Jan. 1, 1995].”

EFFECTIVE DATE OF 1993 AMENDMENT

Section 335 of title III of Pub. L. 103-182 provided that:

“(a) IN GENERAL.—Subject to subsections (b) and (c), the amendments made by this subtitle [subtitle C (§§ 331-335) of title III of Pub. L. 103-182, enacting section 104A of Title 17, Copyrights, amending this section, section 1091 of this title, and section 104 of Title 35, Patents, and amending provisions set out as a note under section 109 of Title 17] take effect on the date the Agreement [North American Free Trade Agreement] enters into force with respect to the United States [Jan. 1, 1994].

“(b) SECTION 331.—The amendments made by section 331 [amending section 104 of Title 35] shall apply to all patent applications that are filed on or after the date of the enactment of this Act [Dec. 8, 1993]: *Provided*, That an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge

or use thereof, or other activity with respect thereto, in a NAFTA country, except as provided in sections 119 and 365 of title 35, United States Code, that is earlier than the date of the enactment of this Act.

“(c) SECTION 333.—The amendments made by section 333 [amending this section and section 1091 of this title] shall apply only to trademark applications filed on or after the date of the enactment of this Act.”

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce to Secretary of Commerce, with certain exceptions, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

URUGUAY ROUND AGREEMENTS: ENTRY INTO FORCE

The Uruguay Round Agreements, including the World Trade Organization Agreement and agreements annexed to that Agreement, as referred to in section 3511(d) of this title, entered into force with respect to the United States on Jan. 1, 1995. See note set out under section 3511 of Title 19, Customs Duties.

MARKS REGISTERED UNDER TEN-YEAR PROVISIO OF TRADE-MARK ACT OF 1905

Marks registered under the “ten-year proviso” of section 5 of the act of Feb. 20, 1905, as amended, deemed to have become distinctive of the registrant’s goods in commerce under par. (f) of this section, see section 46(b) of act July 5, 1946, set out in note under section 1051 of this title.

CROSS REFERENCES

Incontestability of marks used for five consecutive years after registration, see section 1065 of this title.

Supplemental register, subsecs. (e) and (f) inapplicable to trade-marks on, see section 1094 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1051, 1064, 1068, 1091, 1094 of this title.

§ 1053. Service marks registrable

Subject to the provisions relating to the registration of trade-marks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trade-marks, and when registered they shall be entitled to the protection provided in this chapter in the case of trade-marks. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trade-marks.

(July 5, 1946, ch. 540, title I, §3, 60 Stat. 429; Nov. 16, 1988, Pub. L. 100-667, title I, §105, 102 Stat. 3938.)

AMENDMENTS

1988—Pub. L. 100-667 struck out “used in commerce” after “applicable, service marks” and “, except when

used so as to represent falsely that the owner thereof makes or sells the goods on which such mark is used. The Commissioner may establish a separate register for such service marks” after “case of trade-marks”.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

CROSS REFERENCES

Definition of “service mark”, see section 1126 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 1126 of this title.

§ 1054. Collective marks and certification marks registrable

Subject to the provisions relating to the registration of trade-marks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this chapter, in the same manner and with the same effect as are trade-marks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided in this chapter in the case of trade-marks, except in the case of certification marks when used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used. Applications and procedure under this section shall conform as nearly as practicable to those prescribed for the registration of trade-marks.

(July 5, 1946, ch. 540, title I, §4, 60 Stat. 429; Nov. 16, 1988, Pub. L. 100-667, title I, §106, 102 Stat. 3938.)

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §1, 33 Stat. 724; May 4, 1906, ch. 2081, §1, 34 Stat. 168; Feb. 18, 1909, ch. 144, 35 Stat. 628; Apr. 11, 1930, ch. 132, §4, 46 Stat. 155; June 10, 1938, ch. 332, §1, 52 Stat. 638.

AMENDMENTS

1988—Pub. L. 100-667 substituted “origin,” for “origin used in commerce,” and “except in the case of certification marks when” for “except when” and struck out after first sentence “The Commissioner may establish a separate register for such collective marks and certification marks.”

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1052, 1064, 1126 of this title.

§ 1055. Use by related companies affecting validity and registration

Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public. If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.

(July 5, 1946, ch. 540, title I, § 5, 60 Stat. 429; Nov. 16, 1988, Pub. L. 100-667, title I, § 107, 102 Stat. 3938.)

AMENDMENTS

1988—Pub. L. 100-667 inserted at end “If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.”

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

§ 1056. Disclaimer of unregistrable matter

(a) Compulsory and voluntary disclaimers

The Commissioner may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. An applicant may voluntarily disclaim a component of a mark sought to be registered.

(b) Prejudice of rights

No disclaimer, including those made under subsection (e) of section 1057 of this title, shall prejudice or affect the applicant's or registrant's rights then existing or thereafter arising in the disclaimed matter, or his right of registration on another application if the disclaimed matter

be or shall have become distinctive of his goods or services.

(July 5, 1946, ch. 540, title I, § 6, 60 Stat. 429; Oct. 9, 1962, Pub. L. 87-772, § 3, 76 Stat. 769; Nov. 16, 1988, Pub. L. 100-667, title I, § 108, 102 Stat. 3938.)

AMENDMENTS

1988—Subsec. (b). Pub. L. 100-667 substituted “subsection (e)” for “paragraph (d)”.

1962—Pub. L. 87-772, among other changes, provided that an applicant may voluntarily disclaim a component of a mark sought to be registered.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1057. Certificates of registration

(a) Issuance and form

Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Commissioner or have his signature placed thereon, and a record thereof shall be kept in the Patent and Trademark Office. The registration shall reproduce the mark, and state that the mark is registered on the principal register under this chapter, the date of the first use of the mark, the date of the first use of the mark in commerce, the particular goods or services for which it is registered, the number and date of the registration, the term thereof, the date on which the application for registration was received in the Patent and Trademark Office, and any conditions and limitations that may be imposed in the registration.

(b) Certificate as prima facie evidence

A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

(c) Application to register mark considered constructive use

Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the

mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing—

- (1) has used the mark;
- (2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or
- (3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 1126(d) of this title to register the mark which is pending or has resulted in registration of the mark.

(d) Issuance to assignee

A certificate of registration of a mark may be issued to the assignee of the applicant, but the assignment must first be recorded in the Patent and Trademark Office. In case of change of ownership the Commissioner shall, at the request of the owner and upon a proper showing and the payment of the prescribed fee, issue to such assignee a new certificate of registration of the said mark in the name of such assignee, and for the unexpired part of the original period.

(e) Surrender, cancellation, or amendment by registrant

Upon application of the registrant the Commissioner may permit any registration to be surrendered for cancellation, and upon cancellation appropriate entry shall be made in the records of the Patent and Trademark Office. Upon application of the registrant and payment of the prescribed fee, the Commissioner for good cause may permit any registration to be amended or to be disclaimed in part: *Provided*, That the amendment or disclaimer does not alter materially the character of the mark. Appropriate entry shall be made in the records of the Patent and Trademark Office and upon the certificate of registration or, if said certificate is lost or destroyed, upon a certified copy thereof.

(f) Copies of Patent and Trademark Office records as evidence

Copies of any records, books, papers, or drawings belonging to the Patent and Trademark Office relating to marks, and copies of registrations, when authenticated by the seal of the Patent and Trademark Office and certified by the Commissioner, or in his name by an employee of the Office duly designated by the Commissioner, shall be evidence in all cases wherein the originals would be evidence; and any person making application therefor and paying the prescribed fee shall have such copies.

(g) Correction of Patent and Trademark Office mistake

Whenever a material mistake in a registration, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office a certificate stating the fact and nature of such mistake, shall be issued without charge and recorded and a printed copy thereof shall be attached to each printed copy of the registration certificate and such corrected registration shall thereafter have the same ef-

fect as if the same had been originally issued in such corrected form, or in the discretion of the Commissioner a new certificate of registration may be issued without charge. All certificates of correction heretofore issued in accordance with the rules of the Patent and Trademark Office and the registrations to which they are attached shall have the same force and effect as if such certificates and their issue had been specifically authorized by statute.

(h) Correction of applicant's mistake

Whenever a mistake has been made in a registration and a showing has been made that such mistake occurred in good faith through the fault of the applicant, the Commissioner is authorized to issue a certificate of correction or, in his discretion, a new certificate upon the payment of the prescribed fee: *Provided*, That the correction does not involve such changes in the registration as to require republication of the mark.

(July 5, 1946, ch. 540, title I, § 7, 60 Stat. 430; Aug. 17, 1950, ch. 733, 64 Stat. 459; Oct. 9, 1962, Pub. L. 87-772, § 4, 76 Stat. 769; Jan. 2, 1975, Pub. L. 93-596, § 1, 88 Stat. 1949; Nov. 16, 1988, Pub. L. 100-667, title I, § 109, 102 Stat. 3938.)

PRIOR PROVISIONS

Subsecs. (a) and (c) are from acts Feb. 20, 1905, ch. 592, § 11, 33 Stat. 727; Mar. 4, 1925, ch. 535, § 3, 43 Stat. 1269.

Subsec. (e) is from act Mar. 19, 1920, ch. 104, § 7, 41 Stat. 535.

Subsec. (f) is from act Mar. 4, 1925, ch. 535, § 1, 43 Stat. 1268.

AMENDMENTS

1988—Subsec. (b). Pub. L. 100-667, § 109(1), amended subsec. (b) generally. Prior to amendment, subsec. (b) read as follows: "A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registration, registrant's ownership of the mark, and of registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated therein."

Subsec. (c). Pub. L. 100-667, § 109(3), added subsec. (c). Former subsec. (c) redesignated (d).

Subsec. (d). Pub. L. 100-667, § 109(2), (4), redesignated former subsec. (c) as (d) and substituted "prescribed fee" for "fee herein provided". Former subsec. (d) redesignated (e).

Subsec. (e). Pub. L. 100-667, § 109(2), redesignated former subsec. (d) as (e). Former subsec. (e) redesignated (f).

Subsec. (f). Pub. L. 100-667, § 109(2), (5), redesignated former subsec. (e) as (f) and substituted "prescribed fee" for "fee required by law". Former subsec. (f) redesignated (g).

Subsec. (g). Pub. L. 100-667, § 109(2), redesignated former subsec. (f) as (g). Former subsec. (g) redesignated (h).

Subsec. (h). Pub. L. 100-667, § 109(2), (6), redesignated former subsec. (g) as (h) and substituted "prescribed fee" for "required fee".

1975—Subsecs. (a), (c) to (f). Pub. L. 93-596 substituted "Patent and Trademark Office" for "Patent Office".

1962—Subsec. (a). Pub. L. 87-772 substituted "signature placed" for "name printed", and struck out provisions requiring an attestation by an assistant commissioner or by one of the law examiners designated by the Commissioner, together with printed copies of the drawing and statement of the applicant, to be kept in books for that purpose.

Subsec. (d). Pub. L. 87-772, among other charges, removed the requirement of a fee in connection with the voluntary surrender or cancellation of a registration.

Subsec. (e). Pub. L. 87-772 substituted “an employee of the Office” for “a chief of division”, among other changes.

Subsec. (f). Pub. L. 87-772, among other changes, struck out “, signed by the Commissioner and sealed with the seal of the Patent Office” after “nature of such mistake”.

1950—Subsec. (a). Act Aug. 17, 1950, made it unnecessary to include in the certificate a statement of the applicant.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

FEDERAL RULES OF CIVIL PROCEDURE

Proof of official record, see rule 44, Title 28, Appendix, Judiciary and Judicial Procedure.

CROSS REFERENCES

Copies of records relating to trade-marks as evidence, see section 1744 of Title 28, Judiciary and Judicial Procedure.

Supplemental register, subsec. (b) inapplicable to trade-marks on, see section 1094 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1068, 1071, 1092, 1094, 1115 of this title.

§ 1058. Duration of registration

(a) Affidavit of continuing use

Each certificate of registration shall remain in force for ten years: *Provided*, That the registration of any mark under the provisions of this chapter shall be canceled by the Commissioner at the end of six years following its date, unless within one year next preceding the expiration of such six years the registrant shall file in the Patent and Trademark Office an affidavit setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and attaching to the affidavit a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. Special notice of the requirement for such affidavit shall be attached to each certificate of registration.

(b) Registration published under other provisions of law

Any registration published under the provisions of subsection (c) of section 1062 of this title

shall be canceled by the Commissioner at the end of six years after the date of such publication unless within one year next preceding the expiration of such six years the registrant shall file in the Patent and Trademark Office an affidavit showing that said mark is in use in commerce or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark.

(c) Notification of acceptance or refusal of affidavits

The Commissioner shall notify any registrant who files either of the above-prescribed affidavits of his acceptance or refusal thereof and, if a refusal, the reasons therefor.

(July 5, 1946, ch. 540, title I, §8, 60 Stat. 431; Jan. 2, 1975, Pub. L. 93-596, §1, 88 Stat. 1949; Aug. 27, 1982, Pub. L. 97-247, §8, 96 Stat. 320; Nov. 16, 1988, Pub. L. 100-667, title I, §110, 102 Stat. 3939.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §12, 33 Stat. 727.

AMENDMENTS

1988—Subsec. (a). Pub. L. 100-667 substituted “ten” for “twenty” and “setting forth those goods or services recited in the registration on or in connection with which the mark is in use in commerce and attaching to the affidavit a specimen or facsimile showing current use of the mark, or showing that any” for “showing that said mark is in use in commerce or showing that its”.

1982—Subsecs. (a), (b). Pub. L. 97-247 struck out “still” after “showing that said mark is”, and inserted “in commerce” after “use”.

1975—Subsecs. (a), (b). Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97-247, set out as a note under section 294 of Title 35, Patents.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, and saving clause, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

PENDING APPLICATIONS

Act July 5, 1946, ch. 540, title XI, §51, as added Nov. 16, 1988, Pub. L. 100-667, title I, §135, 102 Stat. 3948, provided that: “All certificates of registration based upon applications for registration pending in the Patent and

Trademark Office on the effective date of the Trademark Law Revision Act of 1988 [see Effective Date of 1988 Amendment note set out under section 1051 of this title] shall remain in force for a period of 10 years.”

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 1113 of this title.

§ 1059. Renewal of registration

(a) Period of renewal; time for renewal

Each registration may be renewed for periods of ten years from the end of the expiring period upon payment of the prescribed fee and the filing of a verified application therefor, setting forth those goods or services recited in the registration on or in connection with which the mark is still in use in commerce and having attached thereto, a specimen or facsimile showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse such nonuse and it is not due to any intention to abandon the mark. Such application may be made at any time within six months before the expiration of the period for which the registration was issued or renewed, or it may be made within three months after such expiration on payment of the additional fee herein prescribed.

(b) Notification of refusal of renewal

If the Commissioner refuses to renew the registration, he shall notify the registrant of his refusal and the reasons therefor.

(c) Applicant for renewal not domiciled in United States

An applicant for renewal not domiciled in the United States shall be subject to and comply with the provisions of section 1051(e) of this title.

(July 5, 1946, ch. 540, title I, § 9, 60 Stat. 431; Oct. 9, 1962, Pub. L. 87-772, § 5, 76 Stat. 770; Nov. 16, 1988, Pub. L. 100-667, title I, § 111, 102 Stat. 3939.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, § 12, 33 Stat. 727.

AMENDMENTS

1988—Subsec. (a). Pub. L. 100-667, § 111(1), substituted “ten” for “twenty”.

Subsec. (c). Pub. L. 100-667, § 111(2), substituted “1051(e)” for “1051(d)”.

1962—Pub. L. 87-772 designated existing provisions as subsecs. (a) and (c), added subsec. (b), and among other changes, amended subsec. (a) by substituting provisions requiring a verified application specifying the goods or services recited in the registration on or in connection with which the mark is still in use in commerce and having attached a specimen showing current use of the mark, or showing that any nonuse is due to special circumstances which excuse the nonuse and that it's not due to an intention to abandon the mark, for provisions requiring an affidavit by the registrant stating that the mark is still in use in commerce.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

RENEWAL UNDER PRIOR ACTS

Renewal of registrations under prior acts, see section 46(b) of act July 5, 1946, set out as a note under section 1051 of this title.

EXTENSION OF TIME FOR RENEWAL BY FOREIGN REGISTRANT

Act July 17, 1946, ch. 587, 60 Stat. 568, provided for extension of time for renewal by a foreign registrant and expired by its own terms July 17, 1949.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 1115 of this title.

§ 1060. Assignment of mark; execution; recording; purchaser without notice

A registered mark or a mark for which application to register has been filed shall be assignable with the goodwill of the business in which the mark is used, or with that part of the goodwill of the business connected with the use of and symbolized by the mark.¹ However, no application to register a mark under section 1051(b) of this title shall be assignable prior to the filing of the verified statement of use under section 1051(d) of this title, except to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing. In any assignment authorized by this section it shall not be necessary to include the goodwill of the business connected with the use of and symbolized by any other mark used in the business or by the name or style under which the business is conducted. Assignments shall be by instruments in writing duly executed. Acknowledgment shall be prima facie evidence of the execution of an assignment and when recorded in the Patent and Trademark Office the record shall be prima facie evidence of execution. An assignment shall be void as against any subsequent purchaser for a valuable consideration without notice, unless it is recorded in the Patent and Trademark Office within three months after the date thereof or prior to such subsequent purchase. A separate record of assignments submitted for recording hereunder shall be maintained in the Patent and Trademark Office.

An assignee not domiciled in the United States shall be subject to and comply with the provisions of section 1051(e) of this title.

(July 5, 1946, ch. 540, title I, § 10, 60 Stat. 431; Oct. 9, 1962, Pub. L. 87-772, § 6, 76 Stat. 770; Jan. 2, 1975, Pub. L. 93-596, § 1, 88 Stat. 1949; Nov. 16, 1988, Pub. L. 100-667, title I, § 112, 102 Stat. 3939.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, § 10, 33 Stat. 727.

AMENDMENTS

1988—Pub. L. 100-667 substituted “. However, no application to register a mark under section 1051(b) of this title shall be assignable prior to the filing of the verified statement of use under section 1051(d) of this title, except to a successor to the business of the applicant, or portion thereof, to which the mark pertains, if that business is ongoing and existing. In any assignment authorized by this section” for “and in any such assignment” in first par., and “1051(e)” for “1051(d)” in last par.

¹ So in original.

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Pub. L. 87-772 substituted provisions which require a separate record of assignments to be kept in the Patent Office, for provisions which required the Commissioner to keep such record, and eliminated provisions permitting the cancellation of any assigned registration at any time if the registered mark is being used by, or with the permission of, the assignee so as to misrepresent the source of the goods or services in connection with which the mark is used.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1061. Execution of acknowledgments and verifications

Acknowledgments and verifications required under this chapter may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States or before any official authorized to administer oaths in the foreign country concerned whose authority is proved by a certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, and shall be valid if they comply with the laws of the state or country where made.

(July 5, 1946, ch. 540, title I, § 11, 60 Stat. 432; Aug. 27, 1982, Pub. L. 97-247, § 14(c), 96 Stat. 321.)

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, § 2, 33 Stat. 724; Feb. 18, 1909, ch. 144, 35 Stat. 627.

AMENDMENTS

1982—Pub. L. 97-247 substituted “is” for “shall be” after “whose authority”, and inserted “, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States”.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective Aug. 27, 1982, see section 17(a) of Pub. L. 97-247, set out as a note under section 41 of Title 35, Patents.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations

and rights under prior acts, see notes set out under section 1051 of this title.

§ 1062. Publication

(a) Examination and publication

Upon the filing of an application for registration and payment of the prescribed fee, the Commissioner shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the Commissioner shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office: *Provided*, That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as provided for in section 1066 of this title the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings.

(b) Refusal of registration; amendment of application; abandonment

If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reasons therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Commissioner that the delay in responding was unavoidable, whereupon such time may be extended.

(c) Republication of marks registered under prior acts

A registrant of a mark registered under the provisions of the Act of March 3, 1881, or the Act of February 20, 1905, may, at any time prior to the expiration of the registration thereof, upon the payment of the prescribed fee file with the Commissioner an affidavit setting forth those goods stated in the registration on which said mark is in use in commerce and that the registrant claims the benefits of this chapter for said mark. The Commissioner shall publish notice thereof with a reproduction of said mark in the Official Gazette, and notify the registrant of such publication and of the requirement for the affidavit of use or nonuse as provided for in subsection (b) of section 1058 of this title. Marks published under this subsection shall not be subject to the provisions of section 1063 of this title.

(July 5, 1946, ch. 540, title I, § 12, 60 Stat. 432; Oct. 9, 1962, Pub. L. 87-772, § 7, 76 Stat. 770; Jan. 2, 1975, Pub. L. 93-596, § 1, 88 Stat. 1949; Nov. 16, 1988, Pub. L. 100-667, title I, § 113, 102 Stat. 3940.)

REFERENCES IN TEXT

Acts March 3, 1881 and February 20, 1905, referred to in subsec. (c), are acts Mar. 3, 1881, ch. 138, 21 Stat. 502 and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act

July 5, 1946, ch. 540, §46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §6, 33 Stat. 726; Mar. 2, 1907, ch. 2573, §2, 34 Stat. 1252.

AMENDMENTS

1988—Subsec. (a). Pub. L. 100-667 substituted “prescribed fee” for “fee herein provided”, and “entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1051(d) of this title, the” for “entitled to registration, the”.

1975—Subsec. (a). Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Subsec. (a). Pub. L. 87-772 inserted proviso permitting publication of the mark in the case of an applicant claiming concurrent use, or an application to be placed in an interference, if such mark is otherwise registrable, subject to the determination of the rights of the parties.

Subsec. (c). Pub. L. 87-772 inserted “Marks published under” before “This subsection shall not be subject”.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

CROSS REFERENCES

Cancellation of registration, see section 1064 of this title.

Supplemental register, subsec. (a) inapplicable to trade-marks on, see section 1094 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1058, 1063, 1064, 1065, 1091, 1115 of this title.

§ 1063. Opposition to registration

(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an ex-

tension. The Commissioner shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Commissioner.

(b) Unless registration is successfully opposed—

(1) a mark entitled to registration on the principal register based on an application filed under section 1051(a) of this title or pursuant to section 1126 of this title shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued, and notice of the registration shall be published in the Official Gazette of the Patent and Trademark Office; or

(2) a notice of allowance shall be issued to the applicant if the applicant applied for registration under section 1051(b) of this title.

(July 5, 1946, ch. 540, title I, §13, 60 Stat. 433; Oct. 9, 1962, Pub. L. 87-772, §8, 76 Stat. 771; Jan. 2, 1975, Pub. L. 93-596, §1, 88 Stat. 1949; Jan. 2, 1975, Pub. L. 93-600, §1, 88 Stat. 1955; Aug. 27, 1982, Pub. L. 97-247, §9(a), 96 Stat. 320; Nov. 16, 1988, Pub. L. 100-667, title I, §114, 102 Stat. 3940.)

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §§6, 7, 33 Stat. 726; Mar. 2, 1907, ch. 2573, §2, 34 Stat. 1252.

AMENDMENTS

1988—Pub. L. 100-667 designated existing provisions as subsec. (a), substituted “prescribed fee” for “required fee”, and added subsec. (b).

1982—Pub. L. 97-247 substituted “an” for “a verified” after “required fee, file”, inserted “when requested prior to the expiration of an extension” after “Commissioner for good cause” and struck out provision that an unverified opposition could be filed by a duly authorized attorney, but such opposition would be null and void unless verified by the opposer within a reasonable time after such filing is fixed by the Commissioner.

1975—Pub. L. 93-600 substituted provisions relating to extensions of time for filing opposition upon written request prior to the expiration of the thirty-day period for an additional thirty days, and further extensions for good cause, for provisions relating to extensions of the time for filing opposition for good cause shown.

Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Pub. L. 87-772 inserted “An opposition may be amended under such conditions as may be prescribed by the Commissioner”, and struck out “notice of” after “file a verified” and “time for filing”.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97-247, set out as a note under section 294 of Title 35, Patents.

EFFECTIVE DATE OF 1975 AMENDMENTS

Section 4 of Pub. L. 93-600 provided that: “This Act [amending this section and sections 1071 and 1117 of this title] shall become effective upon enactment [Jan. 2, 1975], but shall not affect any suit, proceeding, or appeal then pending.”

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations

and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

CROSS REFERENCES

Supplemental register, section inapplicable to trademarks on, see section 1094 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1051, 1094 of this title.

§ 1064. Cancellation of registration

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905:

(1) Within five years from the date of the registration of the mark under this chapter.

(2) Within five years from the date of publication under section 1062(c) of this title of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

(4) At any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 1062 of this title.

(5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to

exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies:

Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this chapter, and the prescribed fee shall not be required.

(July 5, 1946, ch. 540, title I, §14, 60 Stat. 433; Oct. 9, 1962, Pub. L. 87-772, §9, 76 Stat. 771; Aug. 27, 1982, Pub. L. 97-247, §9(b), 96 Stat. 320; Nov. 8, 1984, Pub. L. 98-620, title I, §102, 98 Stat. 3335; Nov. 16, 1988, Pub. L. 100-667, title I, §115, 102 Stat. 3940.)

REFERENCES IN TEXT

Acts March 3, 1881 and February 20, 1905, referred to in opening par. and pars. (2) and (4), are acts Mar. 3, 1881, ch. 138, 21 Stat. 502 and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, §46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §13, 33 Stat. 728.

AMENDMENTS

1988—Pub. L. 100-667, §115(1), (7), in introductory provisions, inserted “as follows” and substituted “1905:” for “1905—”, and in concluding proviso substituted “paragraphs (3) and (5)” for “subsections (c) and (e)”.

Par. (1). Pub. L. 100-667, §115(2), substituted “(1) Within” for “(a) within” and “chapter.” for “chapter; or”.

Par. (2). Pub. L. 100-667, §115(3), substituted “(2) Within” for “(b) within”, and “1905.” for “1905; or”.

Par. (3). Pub. L. 100-667, §115(4), substituted “(3)” for “(c)” and amended text generally. Prior to amendment, text read as follows: “at any time if the registered mark becomes the common descriptive name of an article or substance, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsections (a), (b), or (c) of section 1052 of this title for a registration hereunder, or contrary to similar prohibitory provisions of said prior Acts for a registration thereunder, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services in connection with which the mark is used. A registered mark shall not be deemed to be the common descriptive name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the common descriptive name of goods or services in connection with which it has been used; or”.

Par. (4). Pub. L. 100-667, §115(5), substituted “(4) At” for “(d) at”, and “title.” for “title; or”.

Par. (5). Pub. L. 100-667, §115(6), substituted “(5) At” for “(e) at” and redesignated former pars. (1) to (4) as subpars. (A) to (D), respectively.

1984—Par. (c). Pub. L. 98-620 inserted provision that a registered mark shall not be deemed to be the common descriptive name of goods or services solely because such mark is also used as a name of or to identify a

unique product or service, and that the primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the common descriptive name of goods or services in connection with which it has been used.

1982—Pub. L. 97-247 struck out “verified” before “petition to cancel” in provision preceding par. (a).

1962—Pub. L. 87-772 inserted provisions which require a verified petition to cancel a registration, redesignated par. (d) as (e), added par. (d) which is composed of provisions formerly part of par. (c), and in said par. (c), substituted “registrant” for “assignee”, and struck out “on which the patent has expired” before “or has been abandoned”, and “has been assigned and” before “is being used by”.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97-247, set out as a note under section 294 of Title 35, Patents.

FINALITY OF JUDGMENTS PRIOR TO NOVEMBER 8, 1984

Section 104 of title I of Pub. L. 98-620 provided that: “Nothing in this title [amending this section and section 1127 of this title and enacting provisions set out as a note under section 1051 of this title] shall be construed to provide a basis for reopening of any final judgment entered prior to the date of enactment of this title [Nov. 8, 1984].”

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of Federal Trade Commission, with certain exceptions, to Chairman of such Commission, see Reorg. Plan No. 8 of 1950, § 1, eff. May 24, 1950, 15 F.R. 3175, 64 Stat. 1264, set out under section 41 of this title.

RESTRICTION ON USE OF FUNDS TO CANCEL REGISTRATION OF TRADEMARKS

For provisions restricting the use of funds authorized to be appropriated to carry out section 41 et seq. of this title for fiscal year 1980, 1981, or 1982, for the purpose of taking any action under this section with respect to the cancellation of the registration of any mark on the ground that such mark has become the common descriptive name of an article or substance, see section 18 of Pub. L. 96-252, set out as a note under section 57c of this title.

CROSS REFERENCES

Interference and opposition proceedings, see section 1067 of this title.

Supplemental register, section inapplicable to trademarks on, see section 1094 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1065, 1094 of this title.

§ 1065. Incontestability of right to use mark under certain conditions

Except on a ground for which application to cancel may be filed at any time under paragraphs (3) and (5) of section 1064 of this title, and except to the extent, if any, to which the use of

a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark, the right of the registrant to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: *Provided, That—*

(1) there has been no final decision adverse to registrant’s claim of ownership of such mark for such goods or services, or to registrant’s right to register the same or to keep the same on the register; and

(2) there is no proceeding involving said rights pending in the Patent and Trademark Office or in a court and not finally disposed of; and

(3) an affidavit is filed with the Commissioner within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and other matters specified in paragraphs (1) and (2) of this section; and

(4) no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit with the Commissioner within one year after the expiration of any period of five consecutive years after the date of publication of a mark under the provisions of subsection (c) of section 1062 of this title.

The Commissioner shall notify any registrant who files the above-prescribed affidavit of the filing thereof.

(July 5, 1946, ch. 540, title I, § 15, 60 Stat. 433; Oct. 9, 1962, Pub. L. 87-772, § 10, 76 Stat. 771; Jan. 2, 1975, Pub. L. 93-596, § 1, 88 Stat. 1949; Aug. 27, 1982, Pub. L. 97-247, § 10, 96 Stat. 320; Nov. 16, 1988, Pub. L. 100-667, title I, § 116, 102 Stat. 3941.)

REFERENCES IN TEXT

Acts March 3, 1881 and February 20, 1905, referred to in text, are acts Mar. 3, 1881, ch. 138, 21 Stat. 502 and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, § 46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

AMENDMENTS

1988—Pub. L. 100-667, in introductory provisions, substituted “paragraphs (3) and (5)” for “subsections (c) and (e)”, in par. (3) “paragraphs” for “subsections”, and in par. (4) “the generic name for the goods or services or a portion thereof, for which it is registered” for “the common descriptive name of any article or substance, patented or otherwise”.

1982—Pub. L. 97-247 substituted “registration” for “the publication” in provision preceding par. (1).

1975—Par. (2). Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Pub. L. 87-772 substituted “(c) and (e) of section 1064” for “(c) and (d) of section 1064” in provision preceding par. (1), and struck out “or trade name” after “in a mark” in par. (4).

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97-247, set out as a note under section 294 of Title 35, Patents.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

CROSS REFERENCES

Registration of marks used exclusively and continuously for five years preceding application, see section 1052 of this title.

Supplemental register, section inapplicable to trademarks on, see section 1094 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1094, 1115 of this title.

§ 1066. Interference; declaration by Commissioner

Upon petition showing extraordinary circumstances, the Commissioner may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to the use of which has become incontestable.

(July 5, 1946, ch. 540, title I, §16, 60 Stat. 434; Oct. 9, 1962, Pub. L. 87-772, §11, 76 Stat. 771; Aug. 27, 1982, Pub. L. 97-247, §11, 96 Stat. 321; Nov. 16, 1988, Pub. L. 100-667, title I, §117, 102 Stat. 3941.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §7, 33 Stat. 726.

AMENDMENTS

1988—Pub. L. 100-667 substituted “used on or in connection with the goods or services” for “applied to the goods or when used in connection with the services”.

1982—Pub. L. 97-247 substituted “Upon petition showing extraordinary circumstances, the Commissioner may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when applied to the goods or when used in connection with the services of the applicant to cause confusion or mistake or to deceive” for “Whenever application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when applied to the goods or when used in connection with the services of the applicant to cause confusion or mistake or to deceive, the Commissioner may declare that an interference exists”.

1962—Pub. L. 87-772 struck out “purchasers” after “or to deceive”.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective six months after Aug. 27, 1982, see section 17(c) of Pub. L. 97-247, set out as a note under section 294 of Title 35, Patents.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

CROSS REFERENCES

Cancellation of registration, see section 1064 of this title.

Supplemental register, section inapplicable to trademarks on, see section 1094 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1062, 1094 of this title.

§ 1067. Interference, opposition, and proceedings for concurrent use registration or for cancellation; notice; Trademark Trial and Appeal Board

In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Commissioner shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration.

The Trademark Trial and Appeal Board shall include the Commissioner, the Deputy Commissioner, the Assistant Commissioners, and members appointed by the Commissioner. Employees of the Patent and Trademark Office and other persons, all of whom shall be competent in trademark law, shall be eligible for appointment as members. Each case shall be heard by at least three members of the Board, the members hear-

ing such case to be designated by the Commissioner.

(July 5, 1946, ch. 540, title I, §17, 60 Stat. 434; Aug. 8, 1958, Pub. L. 85-609, §1(a), 72 Stat. 540; Jan. 2, 1975, Pub. L. 93-596, §1, 88 Stat. 1949; Oct. 15, 1980, Pub. L. 96-455, §1, 94 Stat. 2024.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §7, 33 Stat. 726.

AMENDMENTS

1980—Pub. L. 96-455 inserted provisions requiring that the Trademark Trial and Appeal Board include the Deputy Commissioner and members appointed by the Commissioner and provisions that employees of the Patent and Trademark Office and other persons, all of whom shall be competent in trademark law, shall be eligible for appointment as members; and struck out provision that the Board include Patent and Trademark Office employees, designated by the Commissioner and whose qualifications have been approved by the Civil Service Commission as being adequate for appointment to the position of examiner in charge of interferences.

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1958—Pub. L. 85-609 substituted “a Trademark Trial and Appeal Board” for “the examiner in charge of interferences” in first paragraph, and inserted second paragraph relating to the composition of the Board.

EFFECTIVE DATE OF 1980 AMENDMENT; BOARD MEMBERSHIP AS OF OCTOBER 15, 1980, UNAFFECTED

Section 2 of Pub. L. 96-455 provided that: “This amendment [amending this section] shall become effective on the date of its enactment [Oct. 15, 1980]. Members of the Trademark Trial and Appeal Board on the date of enactment shall continue to be members under and in accordance with the provisions of section 17 of the Act of July 5, 1946, as amended [this section], in effect immediately preceding the date of enactment.”

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

EFFECTIVE DATE OF 1958 AMENDMENT

Section 3 of Pub. L. 85-609 provided that: “This Act [amending this section and sections 1070, 1071, 1092, and 1113 of this title] shall take effect on approval [Aug. 8, 1958]; it shall apply to ex parte appeals taken to the Commissioner prior to the date of approval which have not been heard but shall not apply to any such appeal which has been heard or decided in which event further proceedings may be had as though this Act had not been passed; it shall apply to inter partes cases instituted prior to the date of approval which have not been heard by an examiner of interferences, but shall not apply to any such case which has been heard or decided by an examiner of interferences in which event further proceedings may be had as though this Act had not passed.”

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

REORGANIZATION PLAN NO. 5 OF 1950

Section 2 of Pub. L. 85-609 provided that: “The provisions of this Act [amending this section and sections 1070, 1071, 1092, and 1113 of this title] shall be subject to Reorganization Plan No. 5 of 1950 (64 Stat. 1263).”

CROSS REFERENCES

Supplemental register, section inapplicable to trademarks on, see section 1094 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 1094 of this title.

§ 1068. Action of Commissioner in interference, opposition, and proceedings for concurrent use registration or for cancellation

In such proceedings the Commissioner may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties under this chapter may be established in the proceedings: *Provided*, That in the case of the registration of any mark based on concurrent use, the Commissioner shall determine and fix the conditions and limitations provided for in subsection (d) of section 1052 of this title. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(July 5, 1946, ch. 540, title I, §18, 60 Stat. 434; Nov. 16, 1988, Pub. L. 100-667, title I, §118, 102 Stat. 3941.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §§7, 13, 33 Stat. 726, 728.

AMENDMENTS

1988—Pub. L. 100-667 substituted “the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register” for “or restrict”, and “may refuse” for “or may refuse”, and inserted provisions that no final judgment be entered before mark is registered if applicant cannot prevail without establishing constructive use.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

dix to Title 5, Government Organization and Employees.

CROSS REFERENCES

Supplemental register, section inapplicable to trademarks on, see section 1094 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 1094 of this title.

§ 1069. Application of equitable principles in inter partes proceedings

In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable may be considered and applied.

(July 5, 1946, ch. 540, title I, § 19, 60 Stat. 434; Jan. 2, 1975, Pub. L. 93-596, § 1, 88 Stat. 1949; Nov. 16, 1988, Pub. L. 100-667, title I, § 119, 102 Stat. 3941.)

AMENDMENTS

1988—Pub. L. 100-667 struck out at end “The provisions of this section shall also govern proceedings heretofore begun in the Patent and Trademark Office and not finally determined.”

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1070. Appeals to Trademark Trial and Appeal Board from decisions of examiners

An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.

(July 5, 1946, ch. 540, title I, § 20, 60 Stat. 435; Aug. 8, 1958, Pub. L. 85-609, § 1(b), 72 Stat. 540.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §§ 8, 13, 33 Stat. 726, 728.

AMENDMENTS

1958—Pub. L. 85-609 substituted “Trademark Trial and Appeal Board” for “Commissioner in person” and “fee” for “fees”, and struck out “of interferences or” after “examiner in charge”.

EFFECTIVE DATE OF 1958 AMENDMENT

For effective date and applicability of amendment by Pub. L. 85-609, see section 3 of Pub. L. 85-609, set out as a note under section 1067 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

REORGANIZATION PLAN NO. 5 OF 1950

Amendment by Pub. L. 85-609 as subject to Reorganization Plan No. 5 of 1950, see note set out under section 1067 of this title.

§ 1071. Appeal to courts

(a) Persons entitled to appeal; United States Court of Appeals for the Federal Circuit; waiver of civil action; election of civil action by adverse party; procedure

(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 1058 of this title, or an applicant for renewal, who is dissatisfied with the decision of the Commissioner or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: *Provided*, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Commissioner, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this section, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b) of this section, in default of which the decision appealed from shall govern the further proceedings in the case.

(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Commissioner, within such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than 60 days after that date.

(3) The Commissioner shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Commissioner forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Commissioner shall submit to that court a brief explaining the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Commissioner and the parties in the appeal.

(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Commissioner, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(b) Civil action; persons entitled to; jurisdiction of court; status of Commissioner; procedure

(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Commissioner or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Commissioner to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(2) The Commissioner shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

(3) In any case where there is no adverse party, a copy of the complaint shall be served on the Commissioner, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse

parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.

(July 5, 1946, ch. 540, title I, § 21, 60 Stat. 435; July 19, 1952, ch. 950, § 2, 66 Stat. 814; Aug. 8, 1958, Pub. L. 85-609, § 1(c), 72 Stat. 540; Oct. 9, 1962, Pub. L. 87-772, § 12, 76 Stat. 771; Jan. 2, 1975, Pub. L. 93-596, § 1, 88 Stat. 1949; Jan. 2, 1975, Pub. L. 93-600, § 2, 88 Stat. 1955; Apr. 2, 1982, Pub. L. 97-164, title I, § 162(1), 96 Stat. 49; Nov. 8, 1984, Pub. L. 98-620, title IV, § 414(b), 98 Stat. 3363; Nov. 16, 1988, Pub. L. 100-667, title I, § 120, 102 Stat. 3942.)

CODIFICATION

Pub. L. 93-596, which provided for the substitution of "Patent and Trademark Office" for "Patent Office" each time appearing in this chapter, became effective Jan. 2, 1975, as did Pub. L. 93-600, which in the course of amending subsecs. (a)(3) and (4) of this section, referred merely to "Patent Office". "Patent and Trademark Office" has been substituted for "Patent Office" in subsecs. (a)(3) and (4) on authority of Pub. L. 93-596.

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §§ 9, 22, 33 Stat. 727, 729; Mar. 2, 1929, ch. 488, § 2(b), 45 Stat. 1478.

AMENDMENTS

1988—Subsec. (a)(1). Pub. L. 100-667, § 120(1), made technical amendments to references in the original act to subsection (b) of this section resulting in no change in text, and substituted "paragraph (2) of this subsection" for "subsection (a)(2) of this section" and "action under subsection" for "action under said subsection".

Subsec. (a)(4). Pub. L. 100-667, § 120(2), inserted provision that no final judgment be entered before mark is registered if applicant cannot prevail without establishing constructive use.

Subsec. (b)(1). Pub. L. 100-667, § 120(3), made technical amendments to references in the original act to subsection (a) of this section resulting in no change in text and inserted provision that no final judgment be entered before mark is registered if applicant cannot prevail without establishing constructive use.

Subsec. (b)(3). Pub. L. 100-667, § 120(4), amended first sentence generally. Prior to amendment, first sentence read as follows: "In all cases where there is no adverse party, a copy of the complaint shall be served on the Commissioner; and all the expenses of the proceedings shall be paid by the party bringing them, whether the final decision is in his favor or not."

1984—Subsec. (a)(2). Pub. L. 98-620 substituted provisions requiring the appellant to file a written notice of appeal in the Patent and Trademark Office directed to the Commissioner for provisions requiring the appellant to file the notice of appeal with the Commissioner, and struck out provision which required the notice of appeal to specify the party or parties taking the appeal, to designate the decision or part thereof appealed from, and to state that the appeal was being taken to the United States Court of Appeals for the Federal Circuit.

Subsec. (a)(3). Pub. L. 98-620 substituted provisions requiring the Commissioner to transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office for provisions which

required the Commissioner to transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant, and any additional papers and evidence specified by the appellee, and inserted provision that the court may request that the Commissioner forward the original or certified copies of such documents during the pendency of the appeal.

Subsec. (a)(4). Pub. L. 98-620 substituted provisions requiring the court to review the decision from which the appeal is taken on the record before the Patent and Trademark Office, and, upon its determination, to issue its mandate and opinion to the Commissioner for provisions which required the court to decide such appeal on the evidence produced before the Patent and Trademark Office and to return to the Commissioner a certificate of its proceedings and decision.

1982—Subsecs. (a)(1), (2), (b)(1). Pub. L. 97-164 substituted “United States Court of Appeals for the Federal Circuit” for “United States Court of Customs and Patent Appeals” and “Court of Customs and Patent Appeals” wherever appearing.

1975—Subsec. (a)(2). Pub. L. 93-600 substituted provisions relating to filing of notice of appeal with the Commissioner and the contents of such notice of appeal, for provisions relating to giving notice of appeal to the Commissioner and requiring filing in the Patent Office reasons for appeal.

Subsec. (a)(3). Pub. L. 93-600 inserted provision requiring the Commissioner to furnish the court with a brief explaining the grounds of the decision of the Office.

Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

Subsec. (a)(4). Pub. L. 93-600 substituted “decide” for “hear and determine” and struck out “Upon its determination,” before “the court shall return” and provision requiring the decision to be confined to the points set forth in the reasons of appeal.

Pub. 93-596 substituted “Patent and Trademark Office” for “Patent Office” in two places.

Subsec. (b)(3), (4). Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Pub. L. 87-772 amended section generally, and among other changes, incorporated with necessary changes in language, the various provisions of Title 35, Patents, relating to the procedure of appeals to the Court of Customs and Patent Appeals and review by civil action in patent cases, which had previously been incorporated by reference only.

1958—Pub. L. 85-609 authorized appeals by persons dissatisfied with the decision of the Trademark Trial and Appeal Board, and substituted “Trademark Trial and Appeal Board” for “Commissioner” in proviso.

1952—Act July 19, 1952, substituted references to new title 35 for repealed section of title 35.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1984 AMENDMENT

Amendment by Pub. L. 98-620 applicable to proceedings pending in the Patent and Trademark Office on Nov. 8, 1984, and to appeals pending in the United States Court of Appeals for the Federal Circuit on that date, see section 414(c) of Pub. L. 98-620, set out as a note under section 142 of Title 35, Patents.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-164 effective Oct. 1, 1982, see section 402 of Pub. L. 97-164, set out as a note under section 171 of Title 28, Judiciary and Judicial Procedure.

EFFECTIVE DATE OF 1975 AMENDMENTS

Amendment by Pub. L. 93-600 effective Jan. 2, 1975, but not to affect any suit, proceeding, or appeal then

pending, see section 4 of Pub. L. 93-600, set out as a note under section 1063 of this title.

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

EFFECTIVE DATE OF 1958 AMENDMENT

For effective date and applicability of amendment by Pub. L. 85-609, see section 3 of Pub. L. 85-609, set out as a note under section 1067 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

REORGANIZATION PLAN NO. 5 OF 1950

Amendment by Pub. L. 85-609 as subject to Reorganization Plan No. 5 of 1950, see note set out under section 1067 of this title.

CROSS REFERENCES

Notice of appeal to be given to the Commissioner of Patents and Trademarks, see section 1116 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in title 28 section 1295.

§ 1072. Registration as constructive notice of claim of ownership

Registration of a mark on the principal register provided by this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, shall be constructive notice of the registrant's claim of ownership thereof.

(July 5, 1946, ch. 540, title I, § 22, 60 Stat. 435.)

REFERENCES IN TEXT

Acts March 3, 1881, and February 20, 1905, referred to in text, are acts Mar. 3, 1881, ch. 138, 21 Stat. 502 and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, § 46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

CROSS REFERENCES

Duty of registrant to give actual notice of registration, see section 1111 of this title.

Supplemental register, section inapplicable to trademarks on, see section 1094 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 1094 of this title.

SUBCHAPTER II—THE SUPPLEMENTAL REGISTER

CROSS REFERENCES

Application of other sections of chapter to marks on supplemental register, see section 1094 of this title.

§ 1091. Supplemental register**(a) Marks registerable**

In addition to the principal register, the Commissioner shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled “An Act to give effect to certain provisions of the convention for the protection of trade-marks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes”, to be called the supplemental register. All marks capable of distinguishing applicant’s goods or services and not registrable on the principal register provided in this chapter, except those declared to be unregistrable under subsections (a), (b), (c), (d), and (e)(3) of section 1052 of this title, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of subsections (a) and (e) of section 1051 of this title so far as they are applicable. Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant’s goods or services and not registrable on the principal register under this chapter, that is declared to be unregistrable under section 1052(e)(3) of this title, if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before December 8, 1993.

(b) Application and proceedings for registration

Upon the filing of an application for registration on the supplemental register and payment of the prescribed fee the Commissioner shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and if on such examination it shall appear that the applicant is entitled to registration, the registration shall be granted. If the applicant is found not entitled to registration the provisions of subsection (b) of section 1062 of this title shall apply.

(c) Nature of mark

For the purposes of registration on the supplemental register, a mark may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname, geographical name, numeral, or device or any combination of any of the foregoing, but such mark must be capable of distinguishing the applicant’s goods or services.

(July 5, 1946, ch. 540, title II, § 23, 60 Stat. 435; Oct. 9, 1962, Pub. L. 87-772, § 13, 76 Stat. 773; Nov. 16, 1988, Pub. L. 100-667, title I, § 121, 102 Stat. 3942; Dec. 8, 1993, Pub. L. 103-182, title III, § 333(b), 107 Stat. 2114.)

REFERENCES IN TEXT

Paragraph (b) of section 1 of the Act of March 19, 1920, referred to in subsec. (a), is paragraph (b) of section 1 of act Mar. 19, 1920, ch. 104, 41 Stat. 533, which was classified to section 121(b) of this title, and repealed by act July 5, 1946, ch. 540, § 46(a), 60 Stat. 444, insofar as inconsistent.

PRIOR PROVISIONS

Acts Mar. 19, 1920, ch. 104, § 1, 41 Stat. 533; Apr. 11, 1930, ch. 132, § 4, 46 Stat. 155; June 10, 1938, ch. 332, § 2, 52 Stat. 638.

AMENDMENTS

1993—Subsec. (a). Pub. L. 103-182 substituted “(d), and (e)(3)” for “and (d)” and inserted at end “Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant’s goods or services and not registrable on the principal register under this chapter, that is declared to be unregistrable under section 1052(e)(3) of this title, if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before December 8, 1993.”

1988—Pub. L. 100-667, § 121(6), struck out undesignated concluding par. which read as follows: “Upon a proper showing by the applicant that he requires domestic registration as a basis for foreign protection of his mark, the Commissioner may waive the requirement of a full year’s use and may grant registration forthwith.”

Subsec. (a). Pub. L. 100-667, § 121(1), (4), designated first par. as subsec. (a), made technical amendment to reference in the original act to subsections (a), (b), (c), and (d) of section 1052 of this title resulting in no change in text, substituted “are in lawful use in commerce by the owner thereof, on” for “have been in lawful use in commerce by the proprietor thereof, upon”, struck out “for the year preceding the filing of the application” after “any goods and services”, and inserted “subsections (a) and (e) of” before “section 1051”.

Subsec. (b). Pub. L. 100-667, § 121(2), (5), designated second par. as subsec. (b) and substituted “prescribed fee” for “fee herein provided”.

Subsec. (c). Pub. L. 100-667, § 121(3), designated third par. as subsec. (c).

1962—Pub. L. 87-772 struck out “has begun the lawful use of his mark in foreign commerce and that he” before “requires domestic registration” in last par.

EFFECTIVE DATE OF 1993 AMENDMENT

Amendment by Pub. L. 103-182 applicable only to trademark applications filed on or after Dec. 8, 1993, see section 335(c) of Pub. L. 103-182, set out in a note under section 1052 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 1126 of this title.

§ 1092. Publication; not subject to opposition; cancellation

Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will

be damaged by the registration of a mark on this register he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Commissioner to cancel such registration. The Commissioner shall refer such application to the Trademark Trial and Appeal Board which shall give notice thereof to the registrant. If it is found after a hearing before the Board that the registrant is not entitled to registration, or that the mark has been abandoned, the registration shall be canceled by the Commissioner. However, no final judgment shall be entered in favor of an applicant under section 1051(b) of this title before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 1057(c) of this title.

(July 5, 1946, ch. 540, title II, §24, 60 Stat. 436; Aug. 8, 1958, Pub. L. 85-609, §1(d), 72 Stat. 540; Oct. 9, 1962, Pub. L. 87-772, §14, 76 Stat. 773; Jan. 2, 1975, Pub. L. 93-596, §1, 88 Stat. 1949; Nov. 16, 1988, Pub. L. 100-667, title I, §122, 102 Stat. 3943.)

PRIOR PROVISIONS

Act Mar. 19, 1920, ch. 104, §2, 41 Stat. 534.

AMENDMENTS

1988—Pub. L. 100-667 struck out “verified” after “filing of a”, substituted “is not entitled to registration,” for “was not entitled to register the mark at the time of his application for registration thereof,” struck out “is not used by the registrant or” after “that the mark”, and inserted provision that no final judgment be entered before mark is registered if applicant cannot prevail without establishing constructive use.

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Pub. L. 87-772 provided for payment of the prescribed fee and the filing of a verified petition.

1958—Pub. L. 85-609 substituted provisions requiring the Commissioner to refer applications to the Trademark Trial and Appeal Board for provisions which required referral to the examiner in charge of interferences.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

EFFECTIVE DATE OF 1958 AMENDMENT

For effective date and applicability of amendment by Pub. L. 85-609, see section 3 of Pub. L. 85-609, set out as a note under section 1067 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

REORGANIZATION PLAN NO. 5 OF 1950

Amendment by Pub. L. 85-609 as subject to Reorganization Plan No. 5 of 1950, see note set out under section 1067 of this title.

§ 1093. Registration certificates for marks on principal and supplemental registers to be different

The certificates of registration for marks registered on the supplemental register shall be conspicuously different from certificates issued for marks registered on the principal register.

(July 5, 1946, ch. 540, title II, §25, 60 Stat. 436.)

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

§ 1094. Provisions of chapter applicable to registrations on supplemental register

The provisions of this chapter shall govern so far as applicable applications for registration and registrations on the supplemental register as well as those on the principal register, but applications for and registrations on the supplemental register shall not be subject to or receive the advantages of sections 1051(b), 1052(e), 1052(f), 1057(b) 1057(c),¹ 1062(a), 1063 to 1068, inclusive, 1072, 1115 and 1124 of this title.

(July 5, 1946, ch. 540, title II, §26, 60 Stat. 436; Nov. 16, 1988, Pub. L. 100-667, title I, §123, 102 Stat. 3943.)

PRIOR PROVISIONS

Act Mar. 19, 1920, ch. 104, §6, 41 Stat. 535.

AMENDMENTS

1988—Pub. L. 100-667 inserted reference to sections 1051(b) and 1057(c).

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

§ 1095. Registration on principal register not precluded

Registration of a mark on the supplemental register, or under the Act of March 19, 1920, shall not preclude registration by the registrant on the principal register established by this chapter. Registration of a mark on the supplemental register shall not constitute an admission that the mark has not acquired distinctiveness.

(July 5, 1946, ch. 540, title II, §27, 60 Stat. 436; Nov. 16, 1988, Pub. L. 100-667, title I, §124, 102 Stat. 3943.)

REFERENCES IN TEXT

Act of March 19, 1920, referred to in text, is act Mar. 19, 1920, ch. 104, §§1-9, 41 Stat. 533, which was generally

¹ So in original. Probably should be “1057(b), 1057(c).”

classified to sections 121 to 128 of this title, and which was repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, §46(a), 60 Stat. 444.

AMENDMENTS

1988—Pub. L. 100-667 inserted at end “Registration of a mark on the supplemental register shall not constitute an admission that the mark has not acquired distinctiveness.”

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

§ 1096. Registration on supplemental register not used to stop importations

Registration on the supplemental register or under the Act of March 19, 1920, shall not be filed in the Department of the Treasury or be used to stop importations.

(July 5, 1946, ch. 540, title II, §28, 60 Stat. 436.)

REFERENCES IN TEXT

Act of March 19, 1920, referred to in text, is act Mar. 19, 1920, ch. 104, §§1-9, 41 Stat. 533, which was generally classified to sections 121 to 128 of this title, and which was repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, §46(b), 60 Stat. 444.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

SUBCHAPTER III—GENERAL PROVISIONS

§ 1111. Notice of registration; display with mark; recovery of profits and damages in infringement suit

Notwithstanding the provisions of section 1072 of this title, a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words “Registered in U.S. Patent and Trademark Office” or “Reg. U.S. Pat. & Tm. Off.” or the letter R enclosed within a circle, thus ®; and in any suit for infringement under this chapter by such a registrant failing to give such notice of registration, no profits and no damages shall be recovered under the provisions of this chapter unless the defendant had actual notice of the registration.

(July 5, 1946, ch. 540, title III, §29, 60 Stat. 436; Oct. 9, 1962, Pub. L. 87-772, §15, 76 Stat. 773; Jan. 2, 1975, Pub. L. 93-596, §§1, 2, 88 Stat. 1949; Nov. 16, 1988, Pub. L. 100-667, title I, §125, 102 Stat. 3943.)

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §28, 33 Stat. 730; Mar. 19, 1920, ch. 104, §§5, 6, 41 Stat. 534, 535.

AMENDMENTS

1988—Pub. L. 100-667 struck out “as used” after “with the mark”.

1975—Pub. L. 93-596 substituted “Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark as used the words ‘Registered in U.S. Patent and Trademark Office’ or ‘Reg. U.S. Pat. & Tm. Off.’” for “Patent Office, may give notice that his mark is registered by displaying with the mark as used the words ‘Registered in U.S. Patent Office’ or ‘Reg. U.S. Pat. Off.’”.

1962—Pub. L. 87-772 substituted “in the Patent Office, may” for “under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register established by this chapter, shall”, and “to give such notice of registration,” for “so to mark goods bearing the registered mark, or by a registrant under the Act of March 19, 1920, or by the registrant of a mark on the supplemental register provided by this chapter”.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Section 4 of Pub. L. 93-596 provided that: “This Act [amending this section, sections 1051, 1052, 1057, 1058, 1060, 1062, 1063, 1065, 1067, 1069, 1071, 1092, 1112, 1113, 1116 to 1120, 1123, and 1127 of this title, and sections 2 to 4, 6 to 8, 10, 11, 21 to 26, 31 to 33, 41, 104, 119, 121, 122, 135, 142 to 144, 146, 152, 153, 253 to 255, 261, 288, and 293 of Title 35, Patents, and enacting provisions set out as a note under section 1 of title 35] shall become effective upon enactment [Jan. 2, 1975]. However, any registrant may continue to give notice of his registration in accordance with section 29 of the Trademark Act of 1946 (60 Stat. 427), as amended Oct. 9, 1962 (76 Stat. 769) [this section], as an alternative to notice in accordance with section 29 of the Trademark Act as amended by section 2 of this Act, regardless of whether his mark was registered before or after the effective date of this Act.”

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

CROSS REFERENCES

Registration as constructive notice of claim to ownership, see section 1072 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 1117 of this title.

§ 1112. Classification of goods and services; registration in plurality of classes

The Commissioner may establish a classification of goods and services, for convenience of Patent and Trademark Office administration, but not to limit or extend the applicant's or registrant's rights. The applicant may apply to register a mark for any or all of the goods or services on or in connection with which he or she is using or has a bona fide intention to use the mark in commerce: *Provided*, That if the Commissioner by regulation permits the filing of an application for the registration of a mark for goods or services which fall within a plurality of classes, a fee equaling the sum of the fees for filing an application in each class shall be paid, and the Commissioner may issue a single certificate of registration for such mark.

(July 5, 1946, ch. 540, title IV, §30, 60 Stat. 436; Oct. 9, 1962, Pub. L. 87-772, §16, 76 Stat. 773; Jan. 2, 1975, Pub. L. 93-596, §1, 88 Stat. 1949; Nov. 16, 1988, Pub. L. 100-667, title I, §126, 102 Stat. 3943.)

PRIOR PROVISIONS

Act May 4, 1906, ch. 2081, § 2, 34 Stat. 169.

AMENDMENTS

1988—Pub. L. 100-667 inserted “or registrant’s” after “applicant’s” and substituted “may apply” for “may file an application”, “goods or services on or in connection with which he or she is using or has a bona fide intention to use the mark in commerce:” for “goods and services upon or in connection with which he is actually using the mark:”, and “*Provided*, That if the Commissioner by regulation permits the filing of an application for the registration of a mark for goods or services which fall” for “*Provided*, That when such goods or services fall”.

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Pub. L. 87-772, among other changes, substituted “may” for “shall”.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1113. Fees**(a) Applications; services; materials**

The Commissioner shall establish fees for the filing and processing of an application for the registration of a trademark or other mark and for all other services performed by and materials furnished by the Patent and Trademark Office related to trademarks and other marks. Fees established under this subsection may be adjusted by the Commissioner once each year to reflect, in the aggregate, any fluctuations during the preceding 12 months in the Consumer Price Index, as determined by the Secretary of Labor. Changes of less than 1 percent may be ignored. No fee established under this section shall take effect until at least 30 days after notice of the fee has been published in the Federal Register and in the Official Gazette of the Patent and Trademark Office.

(b) Waiver; Indian products

The Commissioner may waive the payment of any fee for any service or material related to trademarks or other marks in connection with an occasional request made by a department or agency of the Government, or any officer thereof. The Indian Arts and Crafts Board will not be charged any fee to register Government trademarks of genuineness and quality for Indian

products or for products of particular Indian tribes and groups.

(July 5, 1946, ch. 540, title V, § 31, 60 Stat. 437; Aug. 8, 1958, Pub. L. 85-609, § 1(e), 72 Stat. 540; July 24, 1965, Pub. L. 89-83, § 3, 79 Stat. 260; Jan. 2, 1975, Pub. L. 93-596, § 1, 88 Stat. 1949; Dec. 12, 1980, Pub. L. 96-517, § 5, 94 Stat. 3018; Aug. 27, 1982, Pub. L. 97-247, § 3(f), 96 Stat. 319; Sept. 8, 1982, Pub. L. 97-256, title I, § 103, 96 Stat. 816; Dec. 10, 1991, Pub. L. 102-204, § 5(f)(1), 105 Stat. 1640.)

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §§ 14, 15, 33 Stat. 728; Mar. 19, 1920, ch. 104, § 8, 41 Stat. 535; Apr. 11, 1930, ch. 132, § 4, 46 Stat. 155.

AMENDMENTS

1991—Subsec. (a). Pub. L. 102-204 amended subsec. (a) generally. Prior to amendment, subsec. (a) read as follows: “The Commissioner will establish fees for the filing and processing of an application for the registration of a trademark or other mark and for all other services performed by and materials furnished by the Patent and Trademark Office related to trademarks and other marks. However, no fee for the filing or processing of an application for the registration of a trademark or other mark or for the renewal or assignment of a trademark or other mark will be adjusted more than once every three years. No fee established under this section will take effect prior to sixty days following notice in the Federal Register.”

1982—Subsec. (a). Pub. L. 97-256 struck out “of Patents” after “Commissioner”.

Pub. L. 97-247 struck out provisions directing that fees be set and adjusted by the Commissioner to recover in aggregate 50 per centum of the estimated average cost to the Office of processing and that fees for all other services or materials related to trademarks and other marks recover the estimated average cost to the Office of performing the service or furnishing the material.

1980—Subsec. (a). Pub. L. 96-517 in revising fee provisions required the Commissioner to establish fees based on recovery of estimated average cost of processing applications, performing services and providing material; authorized triennial adjustments; and prescribed an effective date for fees; deleted prior provisions containing statutory schedule covering fees for filing; applications for registration and renewals, affidavits, revival petitions for abandoned applications, opposition or application for cancellation, disclaimers, and notice of benefits for a mark to be published; and fees covering: appeals from examiners in charge of registration, certificates of amendment, certifying, printed copies of registered marks, and recordation of documents and papers relating to property in a registration or application.

Subsec. (b). Pub. L. 96-517 added subsec. (b) and struck out former subsec. (b) authorizing Commissioner to establish charges for copies of records, publications, or services of Patent and Trademark Office. See subsec. (a).

Subsec. (c). Pub. L. 96-517 in revising fee provisions struck out subsec. (c) authorizing Commissioner to refund any mistaken or excessive payments.

1975—Subsec. (a). Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

Subsec. (b). Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1965—Pub. L. 89-83 increased fees for filing an application for registration of a mark from \$25 to \$35; for issuance of a new certificate of registration following a change of ownership of a mark or correction of a registrant’s mistake from \$10 to \$15; for a certificate of correction of registrant’s mistake from \$10 to \$15; for filing a disclaimer from \$10 to \$15; and for recording an assignment, agreement, or other paper relating to the property in a registration or application from \$3 for

documents not exceeding six pages plus \$1 for each additional two pages or less and 50 cents additional for each additional registration or application included in one writing, to a \$20 fee for every document plus an additional fee of \$3 for each additional item where the document relates to more than one application or registration; eliminated provisions which established fees for the surrender or cancellation of a registration, for an abstract of title, for a title report required for office use, for certificates that marks have not been registered, and for copies of various specified records and documents; added the fees for filing and affidavit under section 1058(a) or (b) of this title and for filing a petition for the revival of an abandoned application; empowered the Commissioner to establish charges for copies of records, publications or services furnished by the Patent Office; and made the provisions relating to refunds of sums paid by mistake permissive.

1958—Pub. L. 85-609 struck out “to the Commissioner” after “on appeal from an examiner in charge of the registration of marks”, and provisions which required payment of a \$25 fee on appeals from an examiner in charge of interferences to the Commissioner.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-247 effective Oct. 1, 1982, see section 17(a) of Pub. L. 97-247, set out as a note under section 41 of Title 35, Patents.

EFFECTIVE DATE OF 1980 AMENDMENT

Amendment by Pub. L. 96-517 effective Dec. 12, 1980, with provision for continuation of fees in effect as of such date until corresponding fees are established under this section, see section 8(a), (d) of Pub. L. 96-517, set out as a note under section 41 of Title 35, Patents.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

EFFECTIVE DATE OF 1965 AMENDMENT

For effective date and applicability of amendment by Pub. L. 89-83, see section 7(a), (d) of Pub. L. 89-83, set out as a note under section 41 of Title 35, Patents.

EFFECTIVE DATE OF 1958 AMENDMENT

For effective date and applicability of amendment by Pub. L. 85-609, see section 3 of Pub. L. 85-609, set out as a note under section 1067 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

APPROPRIATIONS AND FEES AUTHORIZED TO BE CARRIED OVER

For provisions authorizing fees collected under this chapter, and certain appropriations, to remain available until expended, see section 2 of Pub. L. 99-607, set out as a note under section 42 of Title 35, Patents.

TRADEMARK FEES

Pub. L. 103-179, §4, Dec. 3, 1993, 107 Stat. 2040, provided that: “Effective on the date of the enactment of this Act [Dec. 3, 1993], the fee under section 31(a) of the Trademark Act of 1946 (15 U.S.C. 1113(a)) for filing an

application for the registration of a trademark shall be \$245. Any adjustment of such fee under the second sentence of such section may not be effective before October 1, 1994.”

Pub. L. 102-204, §5(f)(2), Dec. 10, 1991, 105 Stat. 1640, provided that fees established by Commissioner of Patents and Trademarks under 15 U.S.C. 1113(a) during fiscal year 1992 could reflect fluctuations during the preceding 3 years in the Consumer Price Index and could take effect on or after 1 day after such fees are published in the Federal Register and that the last sentence of 31 U.S.C. 31(a) and 5 U.S.C. 553 did not apply to the establishment of such fees.

Similar provisions were contained in the following prior appropriation acts:

Pub. L. 100-703, title I, §103(a), Nov. 19, 1988, 102 Stat. 4674.

Pub. L. 99-607, §3(a), Nov. 6, 1986, 100 Stat. 3470.

REORGANIZATION PLAN NO. 5 OF 1950

Amendment by Pub. L. 85-609 as subject to Reorganization Plan No. 5 of 1950, see note set out under section 1067 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in title 35 section 42.

§ 1114. Remedies; infringement; innocent infringement by printers and publishers

(1) Any person who shall, without the consent of the registrant—

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive,

shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the acts have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

As used in this subsection,¹ the term “any person” includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(2) Notwithstanding any other provision of this chapter, the remedies given to the owner of a right infringed under this chapter or to a person bringing an action under section 1125(a) of this title shall be limited as follows:

(A) Where an infringer or violator is engaged solely in the business of printing the mark or

¹ So in original. Probably should be “paragraph.”

violating matter for others and establishes that he or she was an innocent infringer or innocent violator, the owner of the right infringed or person bringing the action under section 1125(a) of this title shall be entitled as against such infringer or violator only to an injunction against future printing.

(B) Where the infringement or violation complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical or in an electronic communication as defined in section 2510(12) of title 18, the remedies of the owner of the right infringed or person bringing the action under section 1125(a) of this title as against the publisher or distributor of such newspaper, magazine, or other similar periodical or electronic communication shall be limited to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodicals or in future transmissions of such electronic communications. The limitations of this subparagraph shall apply only to innocent infringers and innocent violators.

(C) Injunctive relief shall not be available to the owner of the right infringed or person bringing the action under section 1125(a) of this title with respect to an issue of a newspaper, magazine, or other similar periodical or an electronic communication containing infringing matter or violating matter where restraining the dissemination of such infringing matter or violating matter in any particular issue of such periodical or in an electronic communication would delay the delivery of such issue or transmission of such electronic communication after the regular time for such delivery or transmission, and such delay would be due to the method by which publication and distribution of such periodical or transmission of such electronic communication is customarily conducted in accordance with sound business practice, and not due to any method or device adopted to evade this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter or violating matter.

(D) As used in this paragraph—

- (i) the term “violator” means a person who violates section 1125(a) of this title; and
- (ii) the term “violating matter” means matter that is the subject of a violation under section 1125(a) of this title.

(July 5, 1946, ch. 540, title VI, § 32, 60 Stat. 437; Oct. 9, 1962, Pub. L. 87-772, § 17, 76 Stat. 773; Nov. 16, 1988, Pub. L. 100-667, title I, § 127, 102 Stat. 3943; Oct. 27, 1992, Pub. L. 102-542, § 3(a), 106 Stat. 3567.)

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, § 16, 33 Stat. 728; Mar. 19, 1920, ch. 104, § 4, 41 Stat. 534.

AMENDMENTS

1992—Par. (1). Pub. L. 102-542 inserted at end “As used in this subsection, the term ‘any person’ includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be

subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.”

1988—Par. (2). Pub. L. 100-667 amended par. (2) generally. Prior to amendment, par. (2) read as follows: “Notwithstanding any other provision of this chapter, the remedies given to the owner of the right infringed shall be limited as follows: (a) Where an infringer in engaged solely in the business of printing the mark for others and establishes that he was an innocent infringer the owner of the right infringed shall be entitled as against such infringer only to an injunction against future printing; (b) where the infringement complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other similar periodical the remedies of the owner of the right infringed as against the publisher or distributor of such newspaper, magazine, or other similar periodical shall be confined to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodical: *Provided*, That these limitations shall apply only to innocent infringers; (c) injunction relief shall not be available to the owner of the right infringed in respect of an issue of a newspaper, magazine, or other similar periodical containing infringing matter when restraining the dissemination of such infringing matter in any particular issue of such periodical would delay the delivery of such issue after the regular time therefor, and such delay would be due to the method by which publication and distribution of such periodical is customarily conducted in accordance with sound business practice, and not to any method or device adopted for the evasion of this section or to prevent or delay the issuance of an injunction or restraining order with respect to such infringing matter.”

1962—Par. (1). Pub. L. 87-772 amended provisions generally, and among other changes, inserted “distribution”, and struck out “purchasers as to the source of origin of such goods or services” after “or to deceive” in subsec. (a), inserted provisions regarding the likelihood of such use causing confusion, mistake, or deception, in subsec. (b), and struck out the limitation on recovery under subsec. (b) to acts committed with knowledge that such acts would deceive purchasers.

Par. (2)(b). Pub. L. 87-772 substituted “publisher” for “published”.

EFFECTIVE DATE OF 1992 AMENDMENT

Section 4 of Pub. L. 102-542 provided that: “The amendments made by this Act [enacting section 1122 of this title and amending this section and sections 1125 and 1127 of this title] shall take effect with respect to violations that occur on or after the date of the enactment of this Act [Oct. 27, 1992].”

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

CROSS REFERENCES

Defenses to action for infringement, see section 1115 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1115, 1116, 1117, 1122 of this title.

§ 1115. Registration on principal register as evidence of exclusive right to use mark; defenses

(a) Evidentiary value; defenses

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b) of this section, which might have been asserted if such mark had not been registered.

(b) Incontestability; defenses

To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 1065 of this title, or in the renewal application filed under the provisions of section 1059 of this title if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 1114 of this title, and shall be subject to the following defenses or defects:

(1) That the registration or the incontestable right to use the mark was obtained fraudulently; or

(2) That the mark has been abandoned by the registrant; or

(3) That the registered mark is being used by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or

(5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or

those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1062 of this title: *Provided, however*, That this defense or defect shall apply only for the area in which such continuous prior use is proved; or

(6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under subsection (c) of section 1062 of this title of the registered mark of the registrant, and not abandoned: *Provided, however*, That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant's mark; or

(7) That the mark has been or is being used to violate the antitrust laws of the United States; or

(8) That equitable principles, including laches, estoppel, and acquiescence, are applicable.

(July 5, 1946, ch. 540, title VI, § 33, 60 Stat. 438; Oct. 9, 1962, Pub. L. 87-772, § 18, 76 Stat. 774; Nov. 16, 1988, Pub. L. 100-667, title I, § 128(a), (b), 102 Stat. 3944.)

REFERENCES IN TEXT

Acts March 3, 1881, and February 20, 1905, referred to in subsec. (a), are acts Mar. 3, 1881, ch. 138, 21 Stat. 502 and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, § 46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

The effective date of the Trademark Law Revision Act of 1988, referred to in subsec. (b)(5), is one year after Nov. 16, 1988. See section 136 of Pub. L. 100-667, set out as an Effective Date of 1988 Amendment note under section 1051 of this title.

The antitrust laws, referred to in subsec. (b)(7), are classified generally to chapter 1 (§1 et seq.) of this title.

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §§ 16, 21, 33 Stat. 728, 729.

AMENDMENTS

1988—Subsec. (a). Pub. L. 100-667, § 128(a), inserted “the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the” after “facie evidence of”, inserted “or in connection with” after “in commerce on”, substituted “another person” for “an opposing party”, and inserted “, including those set forth in subsection (b) of this section,” after “or defect”.

Subsec. (b). Pub. L. 100-667, § 128(b)(1), amended introductory provisions generally. Prior to amendment, introductory provisions read as follows: “If the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the affidavit filed under the provisions of said section 1065 subject to any conditions or limitations stated therein except when one of the following defenses or defects is established:”.

Subsec. (b)(3). Pub. L. 100-667, § 128(b)(2), inserted “on or” after “goods or services”.

Subsec. (b)(4). Pub. L. 100-667, § 128(b)(3), struck out “trade or service” after “than as a” and “to users” after “only to describe”.

Subsec. (b)(5). Pub. L. 100-667, §128(b)(4), substituted “(A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C)” for “registration of the mark under this chapter or”.

Subsec. (b)(8). Pub. L. 100-667, §128(b)(5), (6), added par. (8).

1962—Subsec. (a). Pub. L. 87-772 substituted “registration subject to” for “certificate subject to”, and struck out “certificate of” before “registration issued”.

Subsec. (b). Pub. L. 87-772 substituted “registration shall” for “certificate shall”, and “affidavit filed under the provisions of said section 1065” for “certificate” in text preceding par. (1), substituted “registrant or a person in privity with the registrant,” for “assignee”, and struck out “has been assigned and” after “registered mark” in par. (3), substituted “registration of the mark under this chapter or” for “the”, and struck out “(a) or” before “(c) of section 1062” in par. (5), inserted “registration under this chapter”, substituted “such registration or such” for “the date of”, and struck out “(a) or” before “(c) of section 1062”, “only where the said mark has been published pursuant to subsections (c) of section 1062 of this title and shall apply” after “defect shall apply”, and “under subsection (a) or (c) of section 1062 of this title” after “registrant’s mark”, in par. (6).

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

CROSS REFERENCES

Abandonment of mark, definition of, see section 1127 of this title.

Supplemental register, section inapplicable to trademarks on, see section 1094 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 1094 of this title.

§ 1116. Injunctive relief

(a) Jurisdiction; service

The several courts vested with jurisdiction of civil actions arising under this chapter shall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under section 1125(a) of this title. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction. Any such injunction granted upon hearing, after notice to the defendant, by any district court of the United States, may be served on the parties against whom such injunction is granted anywhere in the United States where they may be found, and shall be operative and may be enforced by proceedings to punish

for contempt, or otherwise, by the court by which such injunction was granted, or by any other United States district court in whose jurisdiction the defendant may be found.

(b) Transfer of certified copies of court papers

The said courts shall have jurisdiction to enforce said injunction, as provided in this chapter, as fully as if the injunction had been granted by the district court in which it is sought to be enforced. The clerk of the court or judge granting the injunction shall, when required to do so by the court before which application to enforce said injunction is made, transfer without delay to said court a certified copy of all papers on file in his office upon which said injunction was granted.

(c) Notice to Commissioner

It shall be the duty of the clerks of such courts within one month after the filing of any action, suit, or proceeding involving a mark registered under the provisions of this chapter to give notice thereof in writing to the Commissioner setting forth in order so far as known the names and addresses of the litigants and the designating number or numbers of the registration or registrations upon which the action, suit, or proceeding has been brought, and in the event any other registration be subsequently included in the action, suit, or proceeding by amendment, answer, or other pleading, the clerk shall give like notice thereof to the Commissioner, and within one month after the judgment is entered or an appeal is taken the clerk of the court shall give notice thereof to the Commissioner, and it shall be the duty of the Commissioner on receipt of such notice forthwith to endorse the same upon the file wrapper of the said registration or registrations and to incorporate the same as a part of the contents of said file wrapper.

(d) Civil actions arising out of use of counterfeit marks

(1)(A) In the case of a civil action arising under section 1114(1)(a) of this title or section 380 of title 36 with respect to a violation that consists of using a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services, the court may, upon ex parte application, grant an order under subsection (a) of this section pursuant to this subsection providing for the seizure of goods and counterfeit marks involved in such violation and the means of making such marks, and records documenting the manufacture, sale, or receipt of things involved in such violation.

(B) As used in this subsection the term “counterfeit mark” means—

(i) a counterfeit of a mark that is registered on the principal register in the United States Patent and Trademark Office for such goods or services sold, offered for sale, or distributed and that is in use, whether or not the person against whom relief is sought knew such mark was so registered; or

(ii) a spurious designation that is identical with, or substantially indistinguishable from, a designation as to which the remedies of this chapter are made available by reason of section 380 of title 36;

but such term does not include any mark or designation used on or in connection with goods or services of which the manufacture or producer was, at the time of the manufacture or production in question authorized to use the mark or designation for the type of goods or services so manufactured or produced, by the holder of the right to use such mark or designation.

(2) The court shall not receive an application under this subsection unless the applicant has given such notice of the application as is reasonable under the circumstances to the United States attorney for the judicial district in which such order is sought. Such attorney may participate in the proceedings arising under such application if such proceedings may affect evidence of an offense against the United States. The court may deny such application if the court determines that the public interest in a potential prosecution so requires.

(3) The application for an order under this subsection shall—

(A) be based on an affidavit or the verified complaint establishing facts sufficient to support the findings of fact and conclusions of law required for such order; and

(B) contain the additional information required by paragraph (5) of this subsection to be set forth in such order.

(4) The court shall not grant such an application unless—

(A) the person obtaining an order under this subsection provides the security determined adequate by the court for the payment of such damages as any person may be entitled to recover as a result of a wrongful seizure or wrongful attempted seizure under this subsection; and

(B) the court finds that it clearly appears from specific facts that—

(i) an order other than an ex parte seizure order is not adequate to achieve the purposes of section 1114 of this title;

(ii) the applicant has not publicized the requested seizure;

(iii) the applicant is likely to succeed in showing that the person against whom seizure would be ordered used a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services;

(iv) an immediate and irreparable injury will occur if such seizure is not ordered;

(v) the matter to be seized will be located at the place identified in the application;

(vi) the harm to the applicant of denying the application outweighs the harm to the legitimate interests of the person against whom seizure would be ordered of granting the application; and

(vii) the person against whom seizure would be ordered, or persons acting in concert with such person, would destroy, move, hide, or otherwise make such matter inaccessible to the court, if the applicant were to proceed on notice to such person.

(5) An order under this subsection shall set forth—

(A) the findings of fact and conclusions of law required for the order;

(B) a particular description of the matter to be seized, and a description of each place at which such matter is to be seized;

(C) the time period, which shall end not later than seven days after the date on which such order is issued, during which the seizure is to be made;

(D) the amount of security required to be provided under this subsection; and

(E) a date for the hearing required under paragraph (10) of this subsection.

(6) The court shall take appropriate action to protect the person against whom an order under this subsection is directed from publicity, by or at the behest of the plaintiff, about such order and any seizure under such order.

(7) Any materials seized under this subsection shall be taken into the custody of the court. The court shall enter an appropriate protective order with respect to discovery by the applicant of any records that have been seized. The protective order shall provide for appropriate procedures to assure that confidential information contained in such records is not improperly disclosed to the applicant.

(8) An order under this subsection, together with the supporting documents, shall be sealed until the person against whom the order is directed has an opportunity to contest such order, except that any person against whom such order is issued shall have access to such order and supporting documents after the seizure has been carried out.

(9) The court shall order that service of a copy of the order under this subsection shall be made by a Federal law enforcement officer (such as a United States marshal or an officer or agent of the United States Customs Service, Secret Service, Federal Bureau of Investigation, or Post Office) or may be made by a State or local law enforcement officer, who, upon making service, shall carry out the seizure under the order. The court shall issue orders, when appropriate, to protect the defendant from undue damage from the disclosure of trade secrets or other confidential information during the course of the seizure, including, when appropriate, orders restricting the access of the applicant (or any agent or employee of the applicant) to such secrets or information.

(10)(A) The court shall hold a hearing, unless waived by all the parties, on the date set by the court in the order of seizure. That date shall be not sooner than ten days after the order is issued and not later than fifteen days after the order is issued, unless the applicant for the order shows good cause for another date or unless the party against whom such order is directed consents to another date for such hearing. At such hearing the party obtaining the order shall have the burden to prove that the facts supporting findings of fact and conclusions of law necessary to support such order are still in effect. If that party fails to meet that burden, the seizure order shall be dissolved or modified appropriately.

(B) In connection with a hearing under this paragraph, the court may make such orders modifying the time limits for discovery under the Rules of Civil Procedure as may be necessary to prevent the frustration of the purposes of such hearing.

(11) A person who suffers damage by reason of a wrongful seizure under this subsection has a

cause of action against the applicant for the order under which such seizure was made, and shall be entitled to recover such relief as may be appropriate, including damages for lost profits, cost of materials, loss of good will, and punitive damages in instances where the seizure was sought in bad faith, and, unless the court finds extenuating circumstances, to recover a reasonable attorney's fee. The court in its discretion may award prejudgment interest on relief recovered under this paragraph, at an annual interest rate established under section 6621 of title 26, commencing on the date of service of the claimant's pleading setting forth the claim under this paragraph and ending on the date such recovery is granted, or for such shorter time as the court deems appropriate.

(July 5, 1946, ch. 540, title VI, §34, 60 Stat. 439; Jan. 2, 1975, Pub. L. 93-596, §1, 88 Stat. 1949; Oct. 12, 1984, Pub. L. 98-473, title II, §1503(1), 98 Stat. 2179; Oct. 22, 1986, Pub. L. 99-514, §2, 100 Stat. 2095; Nov. 16, 1988, Pub. L. 100-667, title I, §128(c)-(e), 102 Stat. 3945; July 2, 1996, Pub. L. 104-153, §6, 110 Stat. 1388.)

REFERENCES IN TEXT

The Rules of Civil Procedure, referred to in subsec. (d)(10)(B), probably means the Federal Rules of Civil Procedure, which are set out in the Appendix to Title 28, Judiciary and Judicial Procedure.

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §§19, 20, 33 Stat. 729; Mar. 3, 1911, ch. 231, §291, 36 Stat. 1167; June 25, 1936, ch. 804, 49 Stat. 1921.

AMENDMENTS

1996—Subsec. (d)(9). Pub. L. 104-153 inserted first sentence and struck out former first sentence which read as follows: "The court shall order that a United States marshal or other law enforcement officer is to serve a copy of the order under this subsection and then is to carry out the seizure under such order."

1988—Subsec. (a). Pub. L. 100-667, §128(c), inserted "or to prevent a violation under section 1125(a) of this title" after "Office" in first sentence.

Subsec. (c). Pub. L. 100-667, §128(d), substituted "proceeding involving a mark registered" for "proceeding arising" and "judgment is entered or an appeal is taken" for "decision is rendered, appeal taken or a decree issued".

Subsec. (d)(1)(B). Pub. L. 100-667, §128(e), inserted "on or" after "or designation used" in concluding provisions.

1986—Subsec. (d)(11). Pub. L. 99-514 substituted "Internal Revenue Code of 1986" for "Internal Revenue Code of 1954", which for purposes of codification was translated as "title 26" thus requiring no change in text.

1984—Pub. L. 98-473 designated first, second, and third undesignated pars. as subsecs. (a), (b), and (c), respectively and added subsec. (d).

1975—Pub. L. 93-596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations

and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

FEDERAL RULES OF CIVIL PROCEDURE

Injunctions, see rule 65, Title 28, Appendix, Judiciary and Judicial Procedure.

Judgment, costs, see rule 54.

FEDERAL RULES OF CRIMINAL PROCEDURE

Criminal contempt, see rule 42, Title 18, Appendix, Crimes and Criminal Procedure.

CROSS REFERENCES

Contempt proceedings, see sections 401, 402, 3285, and 3691 of Title 18, Crimes and Criminal Procedure.

Innocent infringement by publishers, injunction not to issue in certain cases, see section 1114 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1117, 1118, 1122 of this title.

§ 1117. Recovery for violation of rights

(a) Profits; damages and costs; attorney fees

When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, or a violation under section 1125(a) of this title, shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the circumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. The court in exceptional cases may award reasonable attorney fees to the prevailing party.

(b) Treble damages for use of counterfeit mark

In assessing damages under subsection (a) of this section, the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever is greater, together with a reasonable attorney's fee, in the case of any violation of section 1114(1)(a) of this title or section 380 of title 36 that consists of intentionally using a mark or designation, knowing such mark or des-

ignation is a counterfeit mark (as defined in section 1116(d) of this title), in connection with the sale, offering for sale, or distribution of goods or services. In such cases, the court may in its discretion award prejudgment interest on such amount at an annual interest rate established under section 6621 of title 26, commencing on the date of the service of the claimant's pleadings setting forth the claim for such entry and ending on the date such entry is made, or for such shorter time as the court deems appropriate.

(c) Election of award of statutory damages

In a case involving the use of a counterfeit mark (as defined in section 1116(d) of this title) in connection with the sale, offering for sale, or distribution of goods or services, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits under subsection (a) of this section, an award of statutory damages for any such use in connection with the sale, offering for sale, or distribution of goods or services in the amount of—

(1) not less than \$500 or more than \$100,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just; or

(2) if the court finds that the use of the counterfeit mark was willful, not more than \$1,000,000 per counterfeit mark per type of goods or services sold, offered for sale, or distributed, as the court considers just.

(July 5, 1946, ch. 540, title VI, §35, 60 Stat. 439; Oct. 9, 1962, Pub. L. 87-772, §19, 76 Stat. 774; Jan. 2, 1975, Pub. L. 93-596, §1, 88 Stat. 1949; Jan. 2, 1975, Pub. L. 93-600, §3, 88 Stat. 1955; Oct. 12, 1984, Pub. L. 98-473, title II, §1503(2), 98 Stat. 2182; Oct. 22, 1986, Pub. L. 99-514, §2, 100 Stat. 2095; Nov. 16, 1988, Pub. L. 100-667, title I, §129, 102 Stat. 3945; July 2, 1996, Pub. L. 104-153, §7, 110 Stat. 1388.)

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §§16, 19, 33 Stat. 728, 729; Mar. 19, 1920, ch. 104, §4, 41 Stat. 534.

AMENDMENTS

1996—Subsec. (c). Pub. L. 104-153 added subsec. (c).

1988—Subsec. (a). Pub. L. 100-667 inserted “, or a violation under section 1125(a) of this title,” after “Office” in first sentence.

1986—Subsec. (b). Pub. L. 99-514 substituted “Internal Revenue Code of 1986” for “Internal Revenue Code of 1954”, which for purposes of codification was translated as “title 26” thus requiring no change in text.

1984—Pub. L. 98-473 designated existing provisions as subsec. (a) and added subsec. (b).

1975—Pub. L. 93-600 inserted provisions relating to awarding of attorney fees in exceptional cases.

Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

1962—Pub. L. 87-772 substituted “1114” for “1113(1)(b)”.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENTS

Amendment by Pub. L. 93-600 effective Jan. 2, 1975, but not to affect any suit, proceeding, or appeal then pending, see section 4 of Pub. L. 93-600, set out as a note under section 1063 of this title.

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

FEDERAL RULES OF CIVIL PROCEDURE

Judgment, costs, see rule 54, Title 28, Appendix, Judiciary and Judicial Procedure.

CROSS REFERENCES

Damages not recoverable on failure to give notice of registration, see section 1111 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1122, 1125 of this title.

§ 1118. Destruction of infringing articles

In any action arising under this chapter, in which a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, or a violation under section 1125(a) of this title, shall have been established, the court may order that all labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of the defendant, bearing the registered mark or, in the case of a violation of section 1125(a) of this title, the word, term, name, symbol, device, combination thereof, designation, description, or representation that is the subject of the violation, or any reproduction, counterfeit, copy, or colorable imitation thereof, and all plates, molds, matrices, and other means of making the same, shall be delivered up and destroyed. The party seeking an order under this section for destruction of articles seized under section 1116(d) of this title shall give ten days' notice to the United States attorney for the judicial district in which such order is sought (unless good cause is shown for lesser notice) and such United States attorney may, if such destruction may affect evidence of an offense against the United States, seek a hearing on such destruction or participate in any hearing otherwise to be held with respect to such destruction.

(July 5, 1946, ch. 540, title VI, §36, 60 Stat. 440; Jan. 2, 1975, Pub. L. 93-596, §1, 88 Stat. 1949; Oct. 12, 1984, Pub. L. 98-473, title II, §1503(3), 98 Stat. 2182; Nov. 16, 1988, Pub. L. 100-667, title I, §130, 102 Stat. 3945.)

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §20, 33 Stat. 729; Mar. 3, 1911, ch. 231, §291, 36 Stat. 1167; June 25, 1936, ch. 804, 49 Stat. 1921.

AMENDMENTS

1988—Pub. L. 100-667 inserted in first sentence “, or a violation under section 1125(a) of this title,” after “Of-

fice" and "or, in the case of a violation of section 1125(a) of this title, the word, term, name, symbol, device, combination thereof, designation, description, or representation that is the subject of the violation," after "registered mark".

1984—Pub. L. 98-473 inserted "The party seeking an order under this section for destruction of articles seized under section 1116(d) of this title shall give ten days' notice to the United States attorney for the judicial district in which such order is sought (unless good cause is shown for lesser notice) and such United States attorney may, if such destruction may affect evidence of an offense against the United States, seek a hearing on such destruction or participate in any hearing otherwise to be held with respect to such destruction."

1975—Pub. L. 93-596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

FEDERAL RULES OF CRIMINAL PROCEDURE

Criminal contempt, see rule 42, Title 18, Appendix, Crimes and Criminal Procedure.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1122, 1125 of this title.

§ 1119. Power of court over registration

In any action involving a registered mark the court may determine the right to registration, order the cancelation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the court to the Commissioner, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby.

(July 5, 1946, ch. 540, title VI, §37, 60 Stat. 440; Jan. 2, 1975, Pub. L. 93-596, §1, 88 Stat. 1949.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §22, 33 Stat. 729.

AMENDMENTS

1975—Pub. L. 93-596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

FEDERAL RULES OF CIVIL PROCEDURE

Judgment, see rule 54, Title 28, Appendix, Judiciary and Judicial Procedure.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 1122 of this title.

§ 1120. Civil liability for false or fraudulent registration

Any person who shall procure registration in the Patent and Trademark Office of a mark by a false or fraudulent declaration or representation, oral or in writing, or by any false means, shall be liable in a civil action by any person injured thereby for any damages sustained in consequence thereof.

(July 5, 1946, ch. 540, title VI, §38, 60 Stat. 440; Jan. 2, 1975, Pub. L. 93-596, §1, 88 Stat. 1949.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, §25, 33 Stat. 730.

AMENDMENTS

1975—Pub. L. 93-596 substituted "Patent and Trademark Office" for "Patent Office".

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in section 1122 of this title.

§ 1121. Jurisdiction of Federal courts; State and local requirements that registered trademarks be altered or displayed differently; prohibition

(a) The district and territorial courts of the United States shall have original jurisdiction and the courts of appeal of the United States (other than the United States Court of Appeals for the Federal Circuit) shall have appellate ju-

risdiction, of all actions arising under this chapter, without regard to the amount in controversy or to diversity or lack of diversity of the citizenship of the parties.

(b) No State or other jurisdiction of the United States or any political subdivision or any agency thereof may require alteration of a registered mark, or require that additional trademarks, service marks, trade names, or corporate names that may be associated with or incorporated into the registered mark be displayed in the mark in a manner differing from the display of such additional trademarks, service marks, trade names, or corporate names contemplated by the registered mark as exhibited in the certificate of registration issued by the United States Patent and Trademark Office.

(July 5, 1946, ch. 540, title VI, § 39, formerly §§ 39 and 39a, 60 Stat. 440; June 25, 1948, ch. 646, §§ 1, 32(a), 62 Stat. 870, 991; May 24, 1949, ch. 139, § 127, 63 Stat. 107; Apr. 2, 1982, Pub. L. 97-164, title I, § 148, 96 Stat. 46; Oct. 12, 1982, Pub. L. 97-296, 96 Stat. 1316; Nov. 16, 1988, Pub. L. 100-667, title I, § 131, 102 Stat. 3946.)

CODIFICATION

Pub. L. 100-667, § 131(b)(1), transferred section 39a of act July 5, 1946, which was classified to section 1121a of this title, to subsec. (b) of this section.

In subsec. (a), the words “and the United States Court of Appeals for the District of Columbia” following “the Courts of Appeal of the United States” have been deleted as superfluous in view of section 41 of Title 28, Judiciary and Judicial Procedure, which includes the District of Columbia within the eleven judicial circuits of the United States. The word “and” has been inserted preceding “the courts of appeal of the United States” to preserve the conjunctive sense of the sentence.

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, § 17, 33 Stat. 728; Mar. 3, 1911, ch. 231, § 291, 36 Stat. 1167; June 7, 1934, ch. 426, 48 Stat. 926; June 25, 1936, ch. 804, 49 Stat. 1921.

AMENDMENTS

1988—Subsec. (a). Pub. L. 100-667, § 131(a), designated existing provisions as subsec. (a).

Subsec. (b). Pub. L. 100-667, § 131(b), redesignated section 1121a of this title as subsec. (b) of this section and substituted “service marks” for “servicemarks” in two places.

1982—Pub. L. 97-164 inserted “(other than the United States Court of Appeals for the Federal Circuit)”.

CHANGE OF NAME

Act June 25, 1948, eff. Sept. 1, 1948, as amended by act May 24, 1949, substituted “court of appeals” for “circuit court of appeals”.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1982 AMENDMENT

Amendment by Pub. L. 97-164 effective Oct. 1, 1982, see section 402 of Pub. L. 97-164, set out as a note under section 171 of Title 28, Judiciary and Judicial Procedure.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

CROSS REFERENCES

District courts vested with jurisdiction of—

Civil actions arising under any Act of Congress relating to trade-marks, see section 1338 of Title 28, Judiciary and Judicial Procedure.

Civil actions asserting a claim of unfair competition when joined with a substantial and related claim under the trade-mark laws, see section 1338 of Title 28.

Civil actions for injunction against infringement of registered trade-mark, see section 1116 of this title.

District in which trade-mark infringement action to be brought, see section 1391 of Title 28, Judiciary and Judicial Procedure.

§ 1121a. Transferred

CODIFICATION

Section, act July 5, 1946, ch. 540, title VI, § 39a, as added Oct. 12, 1982, Pub. L. 97-296, 96 Stat. 1316, which prohibited State and local requirements that registered trademarks be altered or displayed differently, was transferred to subsec. (b) of section 39 of act July 5, 1946, by section 131(b)(1) of Pub. L. 100-667 and is classified to section 1121(b) of this title.

§ 1122. Liability of States, instrumentalities of States, and State officials

(a) Waiver of sovereign immunity

Any State, instrumentality of a State or any officer or employee of a State or instrumentality of a State acting in his or her official capacity, shall not be immune, under the eleventh amendment of the Constitution of the United States or under any other doctrine of sovereign immunity, from suit in Federal court by any person, including any governmental or non-governmental entity for any violation under this chapter.

(b) Remedies

In a suit described in subsection (a) of this section for a violation described in that subsection, remedies (including remedies both at law and in equity) are available for the violation to the same extent as such remedies are available for such a violation in a suit against any person other than a State, instrumentality of a State, or officer or employee of a State or instrumentality of a State acting in his or her official capacity. Such remedies include injunctive relief under section 1116 of this title, actual damages, profits, costs and attorney's fees under section 1117 of this title, destruction of infringing articles under section 1118 of this title, the remedies provided for under sections 1114, 1119, 1120, 1124 and 1125 of this title, and for any other remedies provided under this chapter.

(July 5, 1946, ch. 540, title VI, § 40, as added Oct. 27, 1992, Pub. L. 102-542, § 3(b), 106 Stat. 3567.)

PRIOR PROVISIONS

A prior section 1122, act July 5, 1946, ch. 540, title VI, § 40, 60 Stat. 440, related to review of cases by the Supreme Court, prior to repeal by act May 24, 1949, ch. 139, § 142, 63 Stat. 109. See section 1254 of Title 28, Judiciary and Judicial Procedure.

EFFECTIVE DATE

Section effective with respect to violations that occur on or after Oct. 27, 1992, see section 4 of Pub. L. 102-542, set out as an Effective Date of 1992 Amendment note under section 1114 of this title.

§ 1123. Rules and regulations for conduct of proceedings in Patent and Trademark Office

The Commissioner shall make rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office under this chapter.

(July 5, 1946, ch. 540, title VI, § 41, 60 Stat. 440; Jan. 2, 1975, Pub. L. 93-596, § 1, 88 Stat. 1949.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, § 26, 33 Stat. 730.

AMENDMENTS

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office”.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5, of 1950, §§ 1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

§ 1124. Importation of goods bearing infringing marks or names forbidden

Except as provided in subsection (d) of section 1526 of title 19, no article of imported merchandise which shall copy or simulate the name of the¹ any domestic manufacture, or manufacturer, or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trade-mark registered in accordance with the provisions of this chapter or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any customhouse of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trade-marks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trade-mark, issued in accordance with the provisions of this chapter, to be recorded in books which shall be

kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trade-mark, and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

(July 5, 1946, ch. 540, title VII, § 42, 60 Stat. 440; Oct. 3, 1978, Pub. L. 95-410, title II, § 211(b), 92 Stat. 903.)

PRIOR PROVISIONS

Act Feb. 20, 1905, ch. 592, § 27, 33 Stat. 730.

AMENDMENTS

1978—Pub. L. 95-410 substituted “Except as provided in subsection (d) of section 1526 of title 19, no article” for “No article”.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

Offices of collector of customs, comptroller of customs, surveyor of customs, and appraiser of merchandise of Bureau of Customs of Department of the Treasury to which appointments were required to be made by President with advice and consent of Senate ordered abolished, with such offices to be terminated not later than Dec. 31, 1966, by Reorg. Plan No. 1 of 1965, eff. May 25, 1965, 30 F.R. 7035, 79 Stat. 1317, set out in the Appendix to Title 5, Government Organization and Employees. Functions of offices eliminated were already vested in Secretary of the Treasury by Reorg. Plan No. 26 of 1950, eff. July 31, 1950, 15 F.R. 4935, 64 Stat. 1280, set out in the Appendix to Title 5.

CROSS REFERENCES

Importation of foreign goods bearing trade-mark owned and registered in United States prohibited, see section 1526 of Title 19, Customs Duties.

Supplemental register, section inapplicable to trade-marks on, see section 1094 of this title.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1094, 1122 of this title; title 19 sections 1484, 1526, 1595a; title 48 section 1643.

§ 1125. False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics,

¹ So in original.

qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(b) Importation

Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.

(c) Remedies for dilution of famous marks

(1) The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to—

(A) the degree of inherent or acquired distinctiveness of the mark;

(B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;

(C) the duration and extent of advertising and publicity of the mark;

(D) the geographical extent of the trading area in which the mark is used;

(E) the channels of trade for the goods or services with which the mark is used;

(F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;

(G) the nature and extent of use of the same or similar marks by third parties; and

(H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(2) In an action brought under this subsection, the owner of the famous mark shall be entitled only to injunctive relief unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If such willful intent is proven, the owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity.

(3) The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution of the distinctiveness of a mark, label, or form of advertisement.

(4) The following shall not be actionable under this section:

(A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.

(B) Noncommercial use of a mark.

(C) All forms of news reporting and news commentary.

(July 5, 1946, ch. 540, title VIII, § 43, 60 Stat. 441; Nov. 16, 1988, Pub. L. 100-667, title I, § 132, 102 Stat. 3946; Oct. 27, 1992, Pub. L. 102-542, § 3(c), 106 Stat. 3568; Jan. 16, 1996, Pub. L. 104-98, § 3(a), 109 Stat. 985.)

REFERENCES IN TEXT

Acts March 3, 1881, and February 20, 1905, referred to in subsec. (c)(1)(H), (3), are acts Mar. 3, 1881, ch. 138, 21 Stat. 502, and Feb. 20, 1905, ch. 592, 33 Stat. 724, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, § 46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title.

PRIOR PROVISIONS

Act Mar. 19, 1920, ch. 104, § 3, 41 Stat. 534.

AMENDMENTS

1996—Subsec. (c). Pub. L. 104-98 added subsec. (c).

1992—Subsec. (a). Pub. L. 102-542 designated existing provisions as par. (1), redesignated former pars. (1) and (2) as subpars. (A) and (B), respectively, and added par. (2).

1988—Subsec. (a). Pub. L. 100-667 amended subsec. (a) generally. Prior to amendment, subsec. (a) read as follows: "Any person who shall affix, apply, or annex, or use in connection with any goods or services, or any container or containers for goods, a false designation of origin, or any false description or representation, including words or other symbols tending falsely to describe or represent the same, and shall cause such goods or services to enter into commerce, and any person who shall with knowledge of the falsity of such designation of origin or description or representation cause or procure the same to be transported or used in commerce or deliver the same to any carrier to be transported or used, shall be liable to a civil action by any person doing business in the locality falsely indicated as that of origin or in the region in which said locality is situated, or by any person who believes that he is or is likely to be damaged by the use of any such false description or representation."

EFFECTIVE DATE OF 1996 AMENDMENT

Section 5 of Pub. L. 104-98 provided that: "This Act [amending this section and section 1127 of this title and enacting provisions set out as a note under section 1051 of this title] and the amendments made by this Act shall take effect on the date of the enactment of this Act [Jan. 16, 1996]."

EFFECTIVE DATE OF 1992 AMENDMENT

Amendment by Pub. L. 102-542 effective with respect to violations that occur on or after Oct. 27, 1992, see section 4 of Pub. L. 102-542, set out as a note under section 1114 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

CROSS REFERENCES

Jurisdiction of protests and appeals under customs law, see sections 1582 and 1583 of Title 28, Judiciary and Judicial Procedure.

Protest against decision of collector of customs, see section 1514 of Title 19, Customs Duties.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1114, 1116, 1117, 1118, 1122 of this title; title 19 section 1595a.

§ 1126. International conventions**(a) Register of marks communicated by international bureaus**

The Commissioner shall keep a register of all marks communicated to him by the international bureaus provided for by the conventions for the protection of industrial property, trade-marks, trade and commercial names, and the repression of unfair competition to which the United States is or may become a party, and upon the payment of the fees required by such conventions and the fees required in this chapter may place the marks so communicated upon such register. This register shall show a facsimile of the mark or trade or commercial name; the name, citizenship, and address of the registrant; the number, date, and place of the first registration of the mark, including the dates on which application for such registration was filed and granted and the term of such registration; a list of goods or services to which the mark is applied as shown by the registration in the country of origin, and such other data as may be useful concerning the mark. This register shall be a continuation of the register provided in section 1(a) of the Act of March 19, 1920.

(b) Benefits of section to persons whose country of origin is party to convention or treaty

Any person whose country of origin is a party to any convention or treaty relating to trade-marks, trade or commercial names, or the repression of unfair competition, to which the United States is also a party, or extends reciprocal rights to nationals of the United States by law, shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of a mark is otherwise entitled by this chapter.

(c) Prior registration in country of origin; country of origin defined

No registration of a mark in the United States by a person described in subsection (b) of this section shall be granted until such mark has been registered in the country of origin of the applicant, unless the applicant alleges use in commerce.

For the purposes of this section, the country of origin of the applicant is the country in which he has a bona fide and effective industrial or commercial establishment, or if he has not such an establishment the country in which he is domiciled, or if he has not a domicile in any of the countries described in subsection (b) of this section, the country of which he is a national.

(d) Right of priority

An application for registration of a mark under section 1051, 1053, 1054, or 1091 of this title, or subsection (e) of this section, filed by a person described in subsection (b) of this section who has previously duly filed an application for registration of the same mark in one of the countries described in subsection (b) of this section shall be accorded the same force and effect as would be accorded to the same application if filed in the United States on the same date on which the application was first filed in such foreign country: *Provided*, That—

(1) the application in the United States is filed within six months from the date on which the application was first filed in the foreign country;

(2) the application conforms as nearly as practicable to the requirements of this chapter, including a statement that the applicant has a bona fide intention to use the mark in commerce;

(3) the rights acquired by third parties before the date of the filing of the first application in the foreign country shall in no way be affected by a registration obtained on an application filed under this subsection;

(4) nothing in this subsection shall entitle the owner of a registration granted under this section to sue for acts committed prior to the date on which his mark was registered in this country unless the registration is based on use in commerce.

In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country, instead of the first filed foreign application: *Provided*, That any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

(e) Registration on principal or supplemental register; copy of foreign registration

A mark duly registered in the country of origin of the foreign applicant may be registered on the principal register if eligible, otherwise on the supplemental register in this chapter provided. The application therefor shall be accompanied by a certification or a certified copy of the registration in the country of origin of the applicant. The application must state the applicant's bona fide intention to use the mark in commerce, but use in commerce shall not be required prior to registration.

(f) Domestic registration independent of foreign registration

The registration of a mark under the provisions of subsections (c), (d), and (e) of this section by a person described in subsection (b) of this section shall be independent of the registration in the country of origin and the duration, validity, or transfer in the United States of such registration shall be governed by the provisions of this chapter.

(g) Trade or commercial names of foreign nationals protected without registration

Trade names or commercial names of persons described in subsection (b) of this section shall be protected without the obligation of filing or registration whether or not they form parts of marks.

(h) Protection of foreign nationals against unfair competition

Any person designated in subsection (b) of this section as entitled to the benefits and subject to the provisions of this chapter shall be entitled to effective protection against unfair competition, and the remedies provided in this chapter for infringement of marks shall be available so far as they may be appropriate in repressing acts of unfair competition.

(i) Citizens or residents of United States entitled to benefits of section

Citizens or residents of the United States shall have the same benefits as are granted by this section to persons described in subsection (b) of this section.

(July 5, 1946, ch. 540, title IX, §44, 60 Stat. 441; Oct. 3, 1961, Pub. L. 87-333, §2, 75 Stat. 748; Oct. 9, 1962, Pub. L. 87-772, §20, 76 Stat. 774; Nov. 16, 1988, Pub. L. 100-667, title I, §133, 102 Stat. 3946.)

REFERENCES IN TEXT

Section 1(a) of the Act of March 19, 1920, referred to in subsec. (a), is section 1(a) of act Mar. 19, 1920, ch. 104, 41 Stat. 533, which was classified to section 121(a) of this title, and repealed by act July 5, 1946, ch. 540, §46(a), 60 Stat. 444, insofar as inconsistent with this chapter.

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, §§1, 2, 4, 33 Stat. 724, 725; May 4, 1906, ch. 2081, §§1, 3, 34 Stat. 168, 169; Feb. 18, 1909, ch. 144, 35 Stat. 628; Mar. 19, 1920, ch. 104, §§1, 6, 41 Stat. 533, 535; Apr. 11, 1930, ch. 132, §4, 46 Stat. 155; June 20, 1936, ch. 617, 49 Stat. 1539; June 10, 1938, ch. 332, §§1, 2, 3, 52 Stat. 638, 639.

AMENDMENTS

1988—Subsec. (a). Pub. L. 100-667, §133(2), substituted “required in this chapter” for “herein prescribed”.

Subsec. (c). Pub. L. 100-667, §133(1), made technical amendment in two places to references in the original act to subsection (b) of this section, resulting in no change in text.

Subsec. (d). Pub. L. 100-667, §133(1), (3), (4), (5), in introductory provisions, made technical amendment in two places to references in the original act to subsection (b) of this section, resulting in no change in text, and substituted “section 1051, 1053, 1054, or 1091 of this title, or subsection (e) of this section” for “sections 1051, 1052, 1053, 1054, or 1091 of this title”, in par. (2), substituted “including a statement that the applicant has a bona fide intention to use the mark in commerce” for “but use in commerce need not be alleged”, and in par. (3), substituted “foreign” for “foreing”.

Subsec. (e). Pub. L. 100-667, §133(6), inserted at end “The application must state the applicant’s bona fide intention to use the mark in commerce, but use in commerce shall not be required prior to registration.”

Subsec. (f). Pub. L. 100-667, §133(1), (7), made technical amendment to references in the original act to subsections (c), (d), and (e) of this section and to subsection (b) of this section, resulting in no change in text.

Subsecs. (g) to (i). Pub. L. 100-667, §133(1), (8), made technical amendment to references in the original act to subsection (b) of this section, resulting in no change in text.

1962—Subsec. (b). Pub. L. 87-772 inserted “or extends reciprocal rights to nationals of the United States by law,” and substituted provisions requiring the person’s country of origin to be a party to any convention or treaty, for provisions which required such persons to be nationals of, domiciled in, or have a bona fide and effective business or commercial establishment in a foreign country which was a party to the International Convention for the Protection of Industrial Property, or the General Inter-American Convention for Trade Mark and Commercial Protection, or any other convention or treaty relating to trademarks, trade, or commercial names.

Subsec. (e). Pub. L. 87-772 inserted “certification or a” after “accompanied by a” and struck out “application for or” before “registration”.

1961—Subsec. (d). Pub. L. 87-333 inserted par. at end authorizing the right provided by this section to be based upon a subsequent application in the same foreign country, instead of the first application, provided that any foreign application filed prior to such subsequent one was withdrawn, or otherwise disposed of, without having been open to public inspection and without leaving any rights outstanding, nor any basis for claiming priority.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1961 AMENDMENT

Section 3 of Pub. L. 87-333 provided that: “This Act [amending this section and section 119 of Title 35, Patents] shall take effect on the date when the Convention of Paris for the Protection of Industrial Property of March 20, 1883, as revised at Lisbon, October 31, 1958, comes into force with respect to the United States and shall apply only to applications thereafter filed in the United States by persons entitled to the benefit of said convention, as revised at the time of such filing.”

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in sections 1051, 1057, 1063 of this title.

§ 1127. Construction and definitions; intent of chapter

In the construction of this chapter, unless the contrary is plainly apparent from the context—

The United States includes and embraces all territory which is under its jurisdiction and control.

The word “commerce” means all commerce which may lawfully be regulated by Congress.

The term “principal register” refers to the register provided for by sections 1051 to 1072 of this title, and the term “supplemental register” refers to the register provided for by sections 1091 to 1096 of this title.

The term “person” and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this chapter includes a juristic person as well as a natural person. The term “juristic person” includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term “person” also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The terms “applicant” and “registrant” embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant.

The term “Commissioner” means the Commissioner of Patents and Trademarks.

The term “related company” means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

The terms “trade name” and “commercial name” mean any name used by a person to identify his or her business or vocation.

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The term “service mark” means any word, name, symbol, or device, or any combination thereof—

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

The term “certification mark” means any word, name, symbol, or device, or any combination thereof—

(1) used by a person other than its owner, or

(2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,

to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

The term “collective mark” means a trademark or service mark—

(1) used by the members of a cooperative, an association, or other collective group or organization, or

(2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

and includes marks indicating membership in a union, an association, or other organization.

The term “mark” includes any trademark, service mark, collective mark, or certification mark.

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

A mark shall be deemed to be “abandoned” if either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motiva-

tion shall not be a test for determining abandonment under this paragraph.

The term “dilution” means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of—

- (1) competition between the owner of the famous mark and other parties, or
- (2) likelihood of confusion, mistake, or deception.

The term “colorable imitation” includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive.

The term “registered mark” means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase “marks registered in the Patent and Trademark Office” means registered marks.

The term “Act of March 3, 1881”, “Act of February 20, 1905”, or “Act of March 19, 1920”, means the respective Act as amended.

A “counterfeit” is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark.

Words used in the singular include the plural and vice versa.

The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trade-marks, trade names, and unfair competition entered into between the United States and foreign nations.

(July 5, 1946, ch. 540, title X, § 45, 60 Stat. 443; Oct. 9, 1962, Pub. L. 87-772, § 21, 76 Stat. 774; Jan. 2, 1975, Pub. L. 93-596, § 1, 88 Stat. 1949; Nov. 8, 1984, Pub. L. 98-620, title I, § 103, 98 Stat. 3335; Nov. 16, 1988, Pub. L. 100-667, title I, § 134, 102 Stat. 3946; Oct. 27, 1992, Pub. L. 102-542, § 3(d), 106 Stat. 3568; Dec. 8, 1994, Pub. L. 103-465, title V, § 521, 108 Stat. 4981; Jan. 16, 1996, Pub. L. 104-98, § 4, 109 Stat. 986.)

REFERENCES IN TEXT

Acts March 3, 1881, February 20, 1905, and March 19, 1920, referred to in text, are acts Mar. 3, 1881, ch. 138, 21 Stat. 502; Feb. 20, 1905, ch. 592, 33 Stat. 724; and Mar. 19, 1920, ch. 104, 41 Stat. 533, which were repealed insofar as inconsistent with this chapter by act July 5, 1946, ch. 540, § 46(a), 60 Stat. 444. Act Feb. 20, 1905, was classified to sections 81 to 109 of this title. Act Mar. 19, 1920, had been generally classified to sections 121 to 128 of this title.

PRIOR PROVISIONS

Acts Feb. 20, 1905, ch. 592, § 29, 33 Stat. 731; June 10, 1938, ch. 332, § 5, 52 Stat. 639.

AMENDMENTS

1996—Pub. L. 104-98 inserted par. defining “dilution” after par. defining “abandoned”.

1994—Pub. L. 103-465 amended par. defining “abandoned” generally. Prior to amendment, par. read as follows: “A mark shall be deemed to be ‘abandoned’ when either of the following occurs:

- “(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie evidence of abandonment. ‘Use’ of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

“(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.”

1992—Pub. L. 102-542 inserted after fourth undesignated par. “The term ‘person’ also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.”

1988—Pub. L. 100-667, § 134(1), amended par. defining “related company” generally. Prior to amendment, par. read as follows: “The term ‘related company’ means any person who legitimately controls or is controlled by the registrant or applicant for registration in respect to the nature and quality of the goods or services in connection with which the mark is used.”

Pub. L. 100-667, § 134(2), amended par. defining “trade name” and “commercial name” generally. Prior to amendment, par. read as follows: “The terms ‘trade name’ and ‘commercial name’ include individual names and surnames, firm names and trade names used by manufacturers, industrialists, merchants, agriculturists, and others to identify their businesses, vocations, or occupations; the names or titles lawfully adopted and used by persons, firms, associations, corporations, companies, unions, and any manufacturing, industrial, commercial, agricultural, or other organizations engaged in trade or commerce and capable of suing and being sued in a court of law.”

Pub. L. 100-667, § 134(3), amended par. defining “trade-mark” generally. Prior to amendment, par. read as follows: “The term ‘trademark’ includes any word, name, symbol, or device or any combination thereof adopted and used by a manufacturer or merchant to identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”

Pub. L. 100-667, § 134(4), amended par. defining “service mark” generally. Prior to amendment, par. read as follows: “The term ‘service mark’ means a mark used in the sale or advertising of services to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.”

Pub. L. 100-667, § 134(5), amended par. defining “certification mark” generally. Prior to amendment, par. read as follows: “The term ‘certification mark’ means a mark used upon or in connection with the products or services of one or more persons other than the owner of the mark to certify regional or other origin, material, mode of manufacture, quality, accuracy or other characteristics of such goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.”

Pub. L. 100-667, § 134(6), amended par. defining “collective mark” generally. Prior to amendment, par. read as follows: “The term ‘collective mark’ means a trade-

mark or service mark used by the members of a cooperative, an association or other collective group or organization and includes marks used to indicate membership in a union, an association or other organization.”

Pub. L. 100-667, §134(7), amended par. defining “mark” generally. Prior to amendment, par. read as follows: “The term ‘mark’ includes any trade-mark, service mark, collective mark, or certification mark entitled to registration under this chapter whether registered or not.”

Pub. L. 100-667, §134(8), substituted par. defining “use in commerce” for former par. which read as follows: “For the purposes of this chapter a mark shall be deemed to be used in commerce (a) on goods when it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto and the goods are sold or transported in commerce and (b) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in this and a foreign country and the person rendering the services is engaged in commerce in connection therewith.” and par. providing when a mark is deemed abandoned for former par. which read as follows: “A mark shall be deemed to be ‘abandoned’—

“(a) When its use has been discontinued with intent not to resume. Intent not to resume may be inferred from circumstances. Nonuse for two consecutive years shall be prima facie abandonment.

“(b) When any course of conduct of the registrant, including acts of omission as well as commission, causes the mark to lose its significance as an indication of origin. Purchaser motivation shall not be a test for determining abandonment under this subparagraph.”

1984—Pub. L. 98-620, §103(1), in definition of “trade-mark” substituted “trademark” for “trade-mark”, and substituted “identify and distinguish his goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown” for “identify his goods and distinguish them from those manufactured or sold by others”.

Pub. L. 98-620, §103(2), in definition of “service mark” substituted “The term ‘service mark’ means a mark used in the sale or advertising of services to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown” for “The term ‘service mark’ means a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others”.

Pub. L. 98-620, §103(3), in subpar. (b) of par. relating to when a mark shall be deemed to be “abandoned”, inserted “Purchaser motivation shall not be a test for determining abandonment under this subparagraph.”

1975—Pub. L. 93-596 substituted “Patent and Trademark Office” for “Patent Office” in two places and “Commissioner of Patents and Trademarks” for “Commissioner of Patents” in definition of “Commissioner”.

1962—Pub. L. 87-772 substituted, “predecessors,” for “and” in definition of “applicant” and “registrant”, “Titles, character names and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor” for “and includes without limitation the marks, names, symbols, titles, designations, slogans, character names, and distinctive features of radio or other advertising used in commerce”, in definition of “service mark”, inserted “or the services are rendered in more than one State or in this and a foreign country and the person rendering the services is engaged in commerce in connection therewith” in fifteenth paragraph relating to use in commerce, struck out “purchasers” after “deceive” in definition of “colorable imitation”, and substituted “commerce” for “commence” in last par. relating to the intent of the chapter.

EFFECTIVE DATE OF 1994 AMENDMENT

Amendment by Pub. L. 103-465 effective one year after the date on which the WTO Agreement enters into force with respect to the United States [Jan. 1, 1995], see section 523 of Pub. L. 103-465, set out as a note under section 1052 of this title.

EFFECTIVE DATE OF 1992 AMENDMENT

Amendment by Pub. L. 102-542 effective with respect to violations that occur on or after Oct. 27, 1992, see section 4 of Pub. L. 102-542, set out as a note under section 1114 of this title.

EFFECTIVE DATE OF 1988 AMENDMENT

Amendment by Pub. L. 100-667 effective one year after Nov. 16, 1988, see section 136 of Pub. L. 100-667, set out as a note under section 1051 of this title.

EFFECTIVE DATE OF 1975 AMENDMENT

Amendment by Pub. L. 93-596 effective Jan. 2, 1975, see section 4 of Pub. L. 93-596, set out as a note under section 1111 of this title.

REPEAL AND EFFECT ON EXISTING RIGHTS

Repeal of inconsistent provisions, effect of this chapter on pending proceedings and existing registrations and rights under prior acts, see notes set out under section 1051 of this title.

TRANSFER OF FUNCTIONS

For transfer of functions of other officers, employees, and agencies of Department of Commerce, with certain exceptions, to Secretary of Commerce, with power to delegate, see Reorg. Plan No. 5 of 1950, §§1, 2, eff. May 24, 1950, 15 F.R. 3174, 64 Stat. 1263, set out in the Appendix to Title 5, Government Organization and Employees.

SECTION REFERRED TO IN OTHER SECTIONS

This section is referred to in title 19 sections 1526, 1595a.

CHAPTER 23—DISSEMINATION OF TECHNICAL, SCIENTIFIC AND ENGINEERING INFORMATION

- | | |
|--------|--|
| Sec. | |
| 1151. | Purpose of chapter. |
| 1152. | Clearinghouse for technical information; removal of security classification. |
| 1153. | Rules, regulations, and fees. |
| 1153a. | Repealed. |
| 1154. | Reference of data to armed services and other Government agencies. |
| 1155. | General standards and limitations; preservation of security classification. |
| 1156. | Use of existing facilities. |
| | (a) Available assistance. |
| | (b) Cooperation of other agencies. |
| 1157. | Relation to other provisions. |

CHAPTER REFERRED TO IN OTHER SECTIONS

This chapter is referred to in section 3704b of this title.

§ 1151. Purpose of chapter

The purpose of this chapter is to make the results of technological research and development more readily available to industry and business, and to the general public, by clarifying and defining the functions and responsibilities of the Department of Commerce as a central clearinghouse for technical information which is useful to American industry and business.

(Sept. 9, 1950, ch. 936, §1, 64 Stat. 823.)